

2004

Judicial Review of Copyright Examination

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JUDICIAL REVIEW OF COPYRIGHT EXAMINATION*

THOMAS G. FIELD, JR.**

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I. INTRODUCTION

Copyright in qualifying United States works has always arisen upon creation.¹ For many years, however, rights could be lost by failing to, e.g., provide notice, register and deposit copies when works were first published.²

* I appreciate the assistance of Robert Kasunic, Senior Attorney and Principal Legal Advisor, and Peter M. Vankevich, Head, Copyright Information Section, U.S. Copyright Office. I also appreciate local help by Jon Cavicchi, Linda Chroniak, Liza MacDonald and Barry Shanks.

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¹ *Wheaton v. Peters*, 33 U.S. 591, 657 (1834):

That an author, at common law, has a property in his manuscript . . . cannot be doubted; but this is a very different right from that which asserts a perpetual and exclusive property in the future publication of the work, after the author shall have published it to the world.

In 1909 formal requirements were reduced,³ and the Supreme Court, in 1939, concluded that registration with the U.S. Copyright Office (Office)⁴ was unnecessary to retain rights.⁵ Despite that, owners could not sue infringers without having registered.⁶ For the most part, that not only remains true for domestic works, but it also applies regardless of publication.⁷ Copyright in works originating abroad may be enforced without registration,⁸ but domestic owners usually cannot initiate litigation without having filed a complete application.⁹

Necessity aside, registration is advantageous for all copyright owners: Certificates constitute prima facie evidence of copyright validity,¹⁰ and prompt registration confers important remedies.¹¹ Those who literally construe any of

² *Id.* at 663.

³ See e.g. *Washingtonian Pub. Co. v. Pearson*, 306 U.S. 30,36(1939):

The Act of 1909 is a complete revision of the copyright laws, different from the earlier Act both in scheme and language. It introduced many changes and was intended definitely to grant valuable, enforceable rights to authors, publishers, etc., without burdensome requirements . . .

⁴ As indicated in *Wheaton*, 33 U.S. at 663, books were then deposited with the Secretary of State. Eventually the Library of Congress became the final depository and an important function of the Office was to collect books for the Library. See U.S. Copyright Office: A Brief History and Overview, at <www.copyright.gov/circs/circ1a.html> (accessed Oct. 25, 2003). See e.g. *105th Annual Report of the Register of Copyrights for the Fiscal Year Ending September 30, 2002*, at 10 <www.copyright.gov/reports/annual/2002/index.html> (“During the fiscal year, the Copyright Office transferred to the Library of Congress for its collections 896,504 copies of registered and unregistered works valued at \$31,302,048.”).

⁵ *Washingtonian*, 306 U.S. at 37 (“[R]espondents rightly say ‘It is no longer necessary to deposit anything to secure a copyright . . . but only to publish with the notice of copyright.’”).

⁶ 306 U.S. 32 (quoting *Id.* at 32 (quoting § 12 of the 1909 Act)).

⁷ 17 U.S.C. § 301(a) (after Jan. 1, 1978 no copyright or equivalent right may be provided by state law). The 1976 Act did not become generally effective until then; Pub. L. No. 94-553, §102, 90 Stat. 2541, 2544-45 (Oct. 19, 1976). Unless otherwise indicated, all subsequent statutory citations are to Title 17 of the U.S. Code (1996).

⁸ See 17 U.S.C. §§ 411(a), 101 (defining “United States” and spelling out its significance in the context of § 411).

⁹ *Id.*; but see e.g. *Foraste v. Brown U.*, 248 F. Supp. 2d 71, 76-77 (D.R.I. 2003) (citing “considerable division of authority regarding a plaintiff’s obligation to obtain and present a certificate of registration prior to filing suit.”).

¹⁰ 17 U.S.C. § 410(c).

¹¹ *Id.* § 412 (statutory damages and attorney fees). When registration must be sought varies depending on whether the work is published or unpublished. *Id.* The effective date of registration is the date upon which a complete application is received by the Office. *Id.* §

several statutory provisions indicating, e.g., that registration is permissive¹² or that protection “subsists” in all “original works of authorship fixed in any tangible medium of expression,”¹³ may thus regret it.

Regarding registration as helpful if not obligatory, this paper compares the burdens on moving parties in circumstances in which registration decisions may be challenged in courts. Most commonly, alleged infringers who question copyright ownership or validity may challenge certificates of registration collaterally.¹⁴

Less commonly, the Office may refuse to register for reasons such as incomplete applications, inadequate evidence of ownership or lack of copyrightable subject matter.¹⁵ In those circumstances, owners may challenge the Office under the Administrative Procedure Act (APA)¹⁶ or, when circumstances permit, join the Office and alleged infringers in a hybrid action seemingly unique to copyright.¹⁷

Examining those three possibilities respectively, this paper aims primarily to support the thesis that judicial deference to the Office’s validity determinations should be influenced less by jurisdictional contexts than by evident support for its position and whether that support is legal or factual.

410(d). See §§ 602, 603. Those sections do not explicitly require registration, *but see* *Oddzon Prods., Inc. v. Oman*, 924 F.2d 346, 347 (D.C. Cir. 1991) (“OddzOn sought copyright registration for the KOOSH ball to block importation of less expensive ‘knockoffs.’”).

¹² 17 U.S.C. § 408(a).

¹³ *Id.* § 102(a).

¹⁴ See e.g. *The Bridgeman Art Lib., Ltd. v. Corel Corp.*, 36 F. Supp. 2d 191, 200 (S.D.N.Y. 1999) (“[W]hile the certificate is *prima facie* evidence of the validity of the copyright, including the originality of the work, the presumption is not irrebuttable.”).

¹⁵ See e.g. *Proulx v. Hennepin Tech. Centers Dist. No. 287*, 1981 WL 1397, *4-5 (D. Minn. 1981) (application not in proper form). The other possibilities are address in detail below.

¹⁶ 17 U.S.C. § 701(e) (makes the APA applicable to the Office); see Pub. L. No. 105-304, Title IV, § 401(a)(2), (b), 112 Stat. 2887, 2888 (Oct. 28, 1998) (Originally § 701(d), the subsection was relabeled when § 701(b) was added in 1998); Administrative Conference of the U.S., *Federal Administrative Procedure Sourcebook* [ACUS Sourcebook] 1 (2d ed., Office of the Chairman, 1992) (the APA, Pub. L. No. 404, 60 Stat 237 (June 11, 1946), was repealed in 1966 “as part of the general revision of [5 U.S.C.]” (§§ 701-706 govern judicial review). That Act, under 5 U.S.C. is hereinafter cited as, e.g. APA § 701.

¹⁷ 17 U.S.C. § 411(a); cf 15 U.S.C. § 1119 (2004) (permitting courts to rectify the trademark register in the context of infringement suits without affording the Patent and Trademark Office (PTO) an opportunity to participate).

Considering matters of law first, the paper will show that the Supreme Court has long deferred to the Office's views in collateral challenges.¹⁸ It will also show that, while the Court has never had occasion to consider direct review of refusals to register copyright, it consistently requires judicial deference to all agencies' legal views when known, reasonable and consistent with their legislation.¹⁹

Matters of fact, however, are much different. The Office's *ex parte* fact-finding is limited.²⁰ Also, unlike the situation with *ex parte* patent examination, for example, fact-based copyright decisions seem not to call for technical expertise.²¹

While jury trials may be unnecessary for other than collateral review,²² one must wonder whether rights regarded as vesting without registration²³ can be effectively divested without hearing. The Office has no apparent obligation to conform to APA adjudication requirements,²⁴ but reviewing courts can easily compensate.²⁵ A second aim of this paper is to spark a long-deferred²⁶ discussion of such matters.²⁷

¹⁸ See e.g. *Washingtonian*, 306 U.S. at 41 n. 4 (crediting the Register's views in concluding that tardy registration did not forfeit copyright in works published with notice); *id.* at 54 (remarkably, as Black, J. pointed out in dissent, those views were only made public after the case was argued). The document to which the opinions refer is Clement L. Bouvé, *Letter to the Librarian of Congress Concerning . . . the Copyright Act of March 4, 1909 . . . with Proposed Amendments* (1938) (available at <www.ipmall.info/hosted_resources/BouveLetter.pdf> (accessed Oct. 16, 2003)).

¹⁹ See e.g. *U.S. v. Mead Corp.*, 533 U.S. 218, 229 (2001) (noting that "a reviewing court has no business rejecting an agency's exercise of its generally conferred authority to resolve a particular statutory ambiguity simply because the agency's chosen resolution seems unwise . . .").

²⁰ See e.g. *Paul Morelli Design, Inc. v. Tiffany and Co.*, 200 F. Supp. 2d 482, 485 (E.D. Pa. 2002) (it appears that registration of jewelry was refused based only on two-dimensional representations).

²¹ See e.g. Kevin Hooper, *Administrative Adjudication and the Various Bases for Court Review in Copyright Registration*, 35 IDEA 129, 133-35 (1994); see also *Norris Indus., Inc. v. Intl. Tel. and Telegraph Corp.*, 696 F.2d 918, 922 (11th Cir. 1983), *cert. denied*, 464 U.S. 818 (1983) (distinguishing fact-based and legal expertise).

²² Cf. *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 349 (1998) ("Actions seeking damages for infringement of common-law copyright, like actions seeking damages for invasions of other property rights were tried in courts of law . . .").

²³ See *supra* nn. 5, 13.

²⁴ APA § 554(a) (requires formal hearings only if subject-specific legislation requires hearings, and provisions related to copyright registration do not).

²⁵ Cf. e.g. *Rydeen v. Quigg*, 748 F. Supp. 900, 903-04 (D.D.C. 1990) (discussing *de novo* review of a decision divesting patent rights without formal administrative process), *aff'd* 937

II. COPYRIGHT REGISTRATION AND COLLATERAL REVIEW

Under § 411(a), registration is unnecessary to enforce copyright in works originating abroad, but, despite criticism²⁸ and efforts to repeal the requirement for domestic works,²⁹ copyright in such works may not ordinarily be enforced without satisfying § 408.³⁰ It reads in relevant part:

[T]he owner of copyright or of any exclusive right in the work may obtain registration of the copyright claim by delivering to the Copyright Office the deposit specified in this section, together with the application and fee specified by sections 409 and 708.³¹

The two sections just referenced respectively authorize the Register to devise forms and fix fees. Section 409 specifies particular information to be gathered³² and permits the Register to collect additional information seen to bear

F.2d 623 (Fed. Cir. 1991) (per curiam) (decision in “Table of Decisions Without Reported Opinions”), *cert. denied* 502 U.S. 1075 (1992).

²⁶ See *supra* n. 5 (it might have been addressed as early as 1939).

²⁷ Few allusions to the adequacy of Office hearings have been found: see Benjamin Kaplan, *Study No. 17, The Registration of Copyright* (1958), in *Copyright Law Revision, Studies [17-19] Prepared for the Subcom. on Patents, Trademarks, and Copyrights of the [Senate] Comm. on the Judiciary*, 1, 65 (Comm. Print, USGPO 1960) (“To the extent to which the Register is given power, the question of affording administrative hearings . . . is naturally presented. This question of hearings was discussed by the Register as early as 1938 and will probably have to be faced as a broader issue in the copyright revision effort.”); *but cf.* 41 Op. Atty. Gen. 395, 399 (1959) (suggesting that a hearing might be required were registration denied to obscene works).

²⁸ See e.g. Shira Perlmutter, *Freeing Copyright from Formalities*, 13 Cardozo Arts & Ent. L.J. 565, 565 (1995) (“It is time for the United States to complete its long and tortuous journey toward eliminating from its copyright system all formal prerequisites for the enjoyment of rights or remedies.”); Charles Ossola, *Registration and Remedies: Recovery of Attorney’s Fees and Statutory Damages under the Copyright Reform Act*, 13 Cardozo Arts & Ent. L.J. 559, 559 (1995); *but see* John B. Koegel, *Bamboozlement: The Repeal of Copyright Registration Incentives*, 13 Cardozo Arts & Ent. L.J. 529, 565 (1995) (He did not, however, argue in favor of forfeiture for failing to register, e.g., within three months of publication as provided in § 412.).

²⁹ *Id.* (The papers discuss that initiative); see also e.g. William J. Hughes, *Introducing the Copyright Reform Act of 1993*, 139 Cong. Rec. E337-01 (daily ed. Feb. 16 1993).

³⁰ That is implied by the 2d and 3d sentences of § 411(a). See also e.g. *Proulx*, 1981 WL 1397 at *4 (“[P]laintiff’s application was not in proper form and his application was not ‘refused’ within the meaning of § 411(a).”); *but cf.* e.g. *Foraste*, 248 F. Supp. 2d at 76-77 (quoted *supra* note 9) (that the court permitted the action to be filed does not necessarily mean that any relief would be granted without registration).

³¹ § 408(a) (“Registration Permissive”).

³² § 409(1)-(10).

upon, e.g., “the existence, ownership, or duration of the copyright.”³³ Section 708 authorizes the Register to adjust fees to cover reasonable costs.³⁴

Registration is typically straight-forward and inexpensive.³⁵ The usual fee is \$30,³⁶ and the Office’s website provides forms³⁷ and instructions³⁸ for registering various types of subject matter³⁹—as well as much other information.⁴⁰ As discussed in detail below, examination is permitted, and applications to register are sometimes refused;⁴¹ historically, however, few works have received attention beyond the formalities. Validity is nevertheless rarely challenged, and infringement litigation is most apt to turn on the scope of copyright.⁴²

³³ § 409(11).

³⁴ § 708(b)(2).

³⁵ *But see e.g. supra* n. 30 (Proulx); Thomas G. Field, Jr., *Copyright on the Internet* <www.piercelaw.edu/tfield/copynet.htm#aut> (accessed May 15, 2003) (describing ambiguity in provisions governing registration of email and website content). After the 1993 legislative initiative mentioned *supra* note 29, the Librarian initiated a thorough review of practices to the end of encouraging registration (and deposits). *See* Robert Wedgeworth & Barbara Ringer, *The Library of Congress Advisory Committee on Copyright Registration and Deposit – Letter and Report of the Co-Chairs*, 17 Colum.-VLA J.L. & Arts 271 (1993) (publishing body of Library of Congress, Advisory Committee on Copyright Registration and Deposit, ACCORD report of 1993). Rule making concerning appeal procedures, 60 Fed. Reg. 21983, 21983 (May 4, 1995), and group registrations of photographs, 66 Fed. Reg. 37142, 37142 (July 17, 2001), are both said to be a direct result of that. Other attempts to simplify and encourage registration are sure to be similarly motivated.

³⁶ *See Current Fees* <www.copyright.gov/docs/fees.html> (accessed June 20, 2003).

³⁷ *See U.S. Copyright Office Forms* <www.copyright.gov/forms/> (accessed May 14, 2003) (forms may also contain instructions).

³⁸ *See Copyright Registration* <www.copyright.gov/register/> (accessed June 11, 2003).

³⁹ *See* § 102(a) (a generic provision followed by eight enumerated types of work, e.g., literary, musical and dramatic, but software is not enumerated). There may also be non-enumerated subject matter, which includes software: *see e.g.* § 101 (definition of “computer program”); § 117 (addressing software rights in detail).

⁴⁰ *See e.g. Information Circulars and Factsheets, and FLs* <www.loc.gov/copyright/circs/> (accessed May 15, 2003). One thing it lacks, however, is the complete Compendium II: Copyright Office Practices (Compendium). *See* <www.copyright.gov/compendium/index.html> (accessed May 15, 2003) (linking to only two chapters, 1600 and 1900, but other chapters are more important to registration).

⁴¹ *Infra* Part III.B.

⁴² *See e.g.* Thomas G. Field, Jr., *Intellectual Property: Some Practical and Legal Fundamentals*, 35 IDEA 79, 104 (1994) (2003 revision online at <www.piercelaw.edu/tfield/plfip.htm>).

On rare occasions when validity or ownership *is* challenged, registration may carry little weight despite a certificate's "constitut[ing] *prima facie* evidence of the validity of the copyright and of the facts stated [therein]."⁴³ Minimal deference is warranted if a case turns on factual issues district courts are procedurally better equipped to address⁴⁴—especially when data provided by a registrant is contested: Lacking means for independent verification, the Office "usually accepts as true the facts given by the applicant."⁴⁵ Although Copyright Examiners "may take notice of matters of general knowledge"⁴⁶ and "use such knowledge as the basis for questioning applications,"⁴⁷ the latter seems highly improbable in most circumstances. Thus, in a case involving ownership, the Sixth Circuit wrote:

Mid-South's filing of a certificate of registration creates a rebuttable presumption . . . Mid-South does not claim that the parties signed a written agreement to consider the brochure a "work made for hire." . . . We agree with the district court that Shaw's deposition testimony, Mid-South's stipulations, and the admissions at the status conference provide sufficient evidence for Habermehl to rebut the presumption of Mid-South's ownership.⁴⁸

That registration may carry little weight is also warranted if validity turns on legal issues that the Office did not and probably should not resolve. Consider, for example, a suit where a British plaintiff argued that its registration certificate established copyright validity.⁴⁹ The Court called the argument "misguided"⁵⁰ and said:

No one disputes that most photographs are copyrightable. In consequence, the issuance of a certificate of registration for a photograph proves nothing. And while the certificate is *prima facie* evidence of the validity of the copyright, including the originality of the work, the presumption is not irrebuttable. Here, the facts pertinent to the issue of originality are undisputed. The Court

⁴³ § 410(c).

⁴⁴ See *supra* nn. 20-21.

⁴⁵ See 60 Fed. Reg. 21983, 21983 (May 4, 1995).

⁴⁶ *Id.* n. 1 (quoting *Compendium II of Copyright Office Practice* § 108.05(b) [1988]).

⁴⁷ *Id.*

⁴⁸ *Mid-South Inst. of Self Defense Shooting, Inc. v. Habermehl*, 2000 WL 924598 *3 (2000) (unpublished); compare *Oklahoma Nat. Gas Co. v. LaRue*, 1998 WL 568321, **3 (10th Cir. 1998) (unpublished) (validity presumption rebutted via work for hire doctrine) with *Ward v. Natl. Geographic Socy.*, 208 F. Supp. 2d 429 (S.D.N.Y. 2002) (validity presumption not rebutted via work for hire doctrine) (the Office refused to register for lack of separate notice on an article in which Ward claimed copyright).

⁴⁹ *Bridgeman Art Lib, Ltd.*, 36 F. Supp. 2d at 192. Because the works originated abroad, that seems to have been unnecessary; see §§ 411(a) and 101 (the latter indicating the meaning of "United States" in the former).

⁵⁰ 36 F.Supp.2d at 200.

has held as a matter of law, and reiterates, that plaintiff's works are not original . . .⁵¹

Once plaintiff admitted that its works were "slavish" imitations of public domain paintings held in art galleries,⁵² the question became whether, absent evidence of more than mechanical reproduction, such works could be deemed sufficiently "original" to qualify for copyright.⁵³ Insofar as the Office does not address such issues, the Court did not overreach to do so.⁵⁴

Likewise, in *Durham*, the Second Circuit held that, when "evidence in the record casts doubt on the question, validity will not be assumed."⁵⁵ Having found "the validity of Tomy's copyrights on its three Disney figures [to be negated by] the mute testimony of Mickey, Donald and Pluto themselves,"⁵⁶ the Court concluded that the figures lacked the originality needed for a valid copyright.⁵⁷

Given that both parties had licensed rights from Disney,⁵⁸ the Court observed that "Tomy has demonstrated, and the toys themselves reflect, no independent creation, no distinguishable variation from preexisting works, nothing recognizably the author's own contribution . . ."⁵⁹ Its view was colored by the observation that "any significant changes made by Durham to avoid liability would carry it away from the original Disney characters, in which

⁵¹ *Id.* (notes omitted).

⁵² *Id.* at 197.

⁵³ *Id.* at 196 (citing *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976) (en banc), cert. denied, 429 U.S. 857 (1976), but, presumably lacking evidence to warrant it, not citing *Alfred Bell & Co. Ltd. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 104 (2d Cir. 1951) ("We consider untenable defendants' suggestion that plaintiff's mezzotints could not validly be copyrighted because they are reproductions of works in the public domain.")).

⁵⁴ See e.g. Caruthers Berger, *Study No. 18, Authority of the Register of Copyrights to Reject Applications for Registration* (1959), in *Copyright Law Revision Studies [17-19] Prepared for the Subcom. on Patents, Trademarks, and Copyrights of the [Senate] Comm. on the Judiciary*, 81, 93 n. 38 (citing originality as difficult to examine).

See Benjamin Kaplan, *Study No. 17, The Registration of Copyright* (1958), in *Copyright Law Revision, Studies [17-19] Prepared for the Subcom. on Patents, Trademarks, and Copyrights of the [Senate] Comm. on the Judiciary*, 1, 65 (Comm. Print, USGPO 1960)

⁵⁵ *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 908 (2d Cir. 1980).

⁵⁶ *Id.*

⁵⁷ *Id.* at 908-09.

⁵⁸ *Id.* at 909, 911.

⁵⁹ *Id.* at 910 (citing *Batlin*, 536 F.2d at 490 and *Alfred Bell & Co.*, 191 F.2d at 102-03, 105); cf. *supra* n. 53.

Tomy concededly has no copyrights, and Disney's right to copy (or to permit others to copy) its own creations would, in effect, be circumscribed."⁶⁰

A similar dispute arose after Skyy Spirits hired plaintiff, and later two other photographers, to produce marketing images of its "iconic blue vodka bottle."⁶¹ Yet, that dispute would seem impossible to resolve on the basis of originality:

Though the Ets-Hokin and Skyy photographs are indeed similar, their similarity is inevitable, given the shared concept, or idea, of photographing the Skyy bottle. When we apply the limiting doctrines, subtracting the unoriginal elements, Ets-Hokin is left with only a "thin" copyright, which protects against only virtually identical copying.⁶²

As with the dispute posed in the previous example, it is difficult to see how the Office could have addressed it in the context of *ex parte* registration.⁶³ Cases falling into the gray zone between ownership and originality are best left for resolution in litigation.⁶⁴

Conversely, courts may sometimes find it advantageous to defer to agencies under the court-made administrative doctrine of primary jurisdiction.⁶⁵ The issue has been addressed in only one copyright case — and there *sua sponte*.⁶⁶ Uncertain whether registrant had conformed to agency regulations,⁶⁷ the Ninth Circuit said:

⁶⁰ 630 F.2d at 911.

⁶¹ *Ets-Hokin v. Skyy Spirits Inc.*, 323 F.3d 763, 765 (9th Cir. 2003).

⁶² *Id.* at 766.

⁶³ *Cf.* concurrent use proceedings in the PTO as provided by 15 U.S.C. §§ 1052(d), 1067.

⁶⁴ In a similar vein, involving a very different issue, *see also Morrissey v. Procter & Gamble Co.*, 379 F.2d 675, 678 (1st Cir. 1967) ("When the uncopyrightable subject matter is very narrow, so that 'the topic necessarily requires,' if not only one form of expression, at best only a limited number, to permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance." (internal citations omitted)).

⁶⁵ *But see PHC Inc. v. Pioneer Health Care Inc.*, 75 F.3d 75, 80 (1st Cir. 1996) ("The primary jurisdiction rubric is less an organized doctrine than a set of precedents that guide courts in deciding when an issue should be resolved in the first instance by an agency that has special competence to address it.").

⁶⁶ *Syntek Semiconductor Co. v. Microchip Tech. Inc.*, 307 F.3d 775, 780 n.2 (9th Cir. 2002).

⁶⁷ *See Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wash.*, 334 F.3d 1264, 1266 (Fed. Cir. 2003) ("An agency's interpretation of its own regulations is entitled to substantial deference, and that interpretation will be accepted unless it is plainly erroneous or inconsistent with the regulation." (citing *Auer v. Robbins*, 519 U.S. 452, 461-62 (1997)); *see also, Bowles v. Seminole Rock & Sand Co.*, 325 U.S. 410, 414 (1945) (leading to use of the term "Seminole deference").

[I]t is important to note that Syntek does not seek a declaratory judgment that Microchip's *copyright* is invalid, just that Microchip's copyright *registration* is invalid. This is in contrast to the typical lawsuit . . . [R]esolution of the question at hand requires an analysis of whether the agency acted in conformance with its own regulations when it granted the registration. Accordingly, referral to the agency for consideration of these issues in the first instance is particularly appropriate.⁶⁸

Similar measures might be considered in other cases because justifications for registration are not required by statute, and explaining run-of-the mill works would be infeasible without substantially increasing fees.⁶⁹

Current examination practices leave courts to speculate about whether, for example, an individual examiner made a mistake⁷⁰ or the registrant misrepresented the work⁷¹ — or why an appeal to high-level officials was successful.⁷² Thus, the Third Circuit, in *Masquerade Novelty*, wrote:

Absent an indication from the Copyright Office as to why it registered the nose masks, or the existence of a controlling administrative regulation or

⁶⁸ *Syntek Semiconductor Co.*, 307 F.3d at 781 (emphasis added). Although the issue is well beyond the scope of this paper, it warrants mention that, primary jurisdiction is usually invoked when an agency proceeding is already underway — as in *PHC*, quoted *supra* note 65. That was not true in *Syntek*, and it is doubtful that the Office would have taken action solely at the behest of a non-registrant; see *infra* n. 128.

⁶⁹ See *supra* nn. 34, 36 (the basic registration fee is currently \$30).

⁷⁰ As discussed in remaining parts of this paper, when registration is refused, the matter receives close attention, but that is uncommon. Cf. *In re Wilson*, 57 U.S.P.Q.2d (BNA) 1863, 1871 (PTO Trademark Tr. & App. Bd. 2001) (“the Board is not bound by prior decisions of Trademark Examining Attorneys”).

⁷¹ *Compare Grundberg v. Upjohn Co.*, 137 F.R.D. 372, 378, 383 (D. Utah 1991) (finding documents registered as a collection not to qualify under an Office regulation when, among other things, Upjohn “apparently did not advise the Copyright Office that many of the documents were covered by a protective order of this court.”) with e.g. *Whimsicality, Inc. v. Rubie's Costume Co.*, 836 F. Supp. 112 (E.D. N.Y. 1993) (discussing a Copyright Office affidavit offered to rebut an allegation that plaintiff had misled it).

Although § 508 mandates notice of collateral proceedings and § 501(b) permits intervention of “any person having or claiming an interest in the copyright,” the Office apparently does not. But see *Mazer v. Stein*, 347 U.S. 201, 204 n. 4 (1954); *Raquel v. Educ. Mgmt. Corp.*, 531 U.S. 952 (2000) (mem) — both discussed below in this part of the paper.

⁷² See *Esquire, Inc. v. Ringer*, 591 F.2d 796, 802 (D.C. Cir. 1978) (Whether the Register's interpretation has been consistently followed for a significant period of time is somewhat less clear. Since the Copyright Office does not publish opinions explaining registration decisions, there is little evidence bearing directly on this point. What evidence exists, however, indicates that the Register's construction has been followed consistently.”); see also e.g. *Letter Re: Bracelet B4260 and Bracelet B6055*, 1 (Copy. Off. App. Bd. Jul. 6, 1999) (accepting only the latter of a pair of bracelets “in light of the arguments [an attorney] made”). Regarding current authority for intramural appeals, see *infra* notes 130-31.

interpretation of [relevant statutory language], the only deference we can give to the Copyright Office's expertise . . . , and the only meaning we can give to § 410(c) is to place the burden on Unique to show that the articles are not copyrightable.⁷³

Insofar as that Court subsequently noted that "courts have twisted themselves into knots" trying to determine the extent of copyright available for "useful" articles,⁷⁴ it seems inclined to have deferred had the decision to register been better documented.

If referral and better documentation for bulk of typical registrations is not warranted, one solution to the dilemma is for the Office to promulgate more rules or to better explain existing ones.⁷⁵ In that regard, a recent Supreme Court opinion warrants extended quotation:

The fair measure of deference to an agency administering its own statute has been understood to vary with circumstances, and courts have looked to the degree of the agency's care, its consistency, formality, and relative expertness, and to the persuasiveness of the agency's position. . . . "The weight [accorded to an administrative] judgment in a particular case will depend upon the thoroughness evident in its consideration, the validity of its reasoning, its consistency with earlier and later pronouncements, and all those factors which give it power to persuade, if lacking power to control." [Skidmore v. Swift & Co., 323 U.S. 134, 140 (1944).]

Since 1984, we have identified a category of interpretive choices distinguished by an additional reason for judicial deference. This Court in *Chevron* recognized that Congress not only engages in express delegation of specific interpretive authority, but that "[s]ometimes the legislative delegation to an agency on a particular question is implicit." 467 U.S. at 844. Congress, that is, may not have expressly delegated authority or responsibility to implement a particular provision or fill a particular gap. Yet it can still be apparent from the agency's generally conferred authority and other statutory circumstances that Congress would expect the agency to be able to speak with the force of law when it addresses ambiguity in the statute or fills a space in the enacted law, even one about which "Congress did not actually have an intent" as to a particular result. *Id.* at 845. When circumstances implying such an expectation exist, a reviewing court has no business rejecting an agency's exercise of its generally conferred authority to resolve a particular statutory ambiguity simply because the agency's chosen resolution seems unwise but is obliged to accept the agency's position if Congress has not previously spoken to the point at issue and the agency's interpretation is reasonable; *cf.* 5 U.S.C. § 706(2) . . .⁷⁶

⁷³ *Masquerade Novelty, Inc. v. Unique Indus., Inc.*, 912 F.2d 663, 669 n.7 (3d Cir. 1990).

⁷⁴ *Id.* at 670.

⁷⁵ See § 702; see also e.g. *Sun Ray Drive-In Dairy, Inc. v. Or. Liquor Control Comm.*, 517 P.2d 289, 293 (Ct. App. Or. 1973) ("Unwritten standards and policies are no better than no standards and policies at all. Without written, published standards, the entire system of administrative law loses its keystone."). Rules may also be supplemented with Office decisions of the kind cited *supra* note 72.

⁷⁶ *Mead*, 533 U.S. at 228-29 (some citations omitted) (first and third brackets in original).

Although the analysis concerned direct challenges to agencies' legal views, nothing indicates that the Court is less inclined to apply it to collateral challenges.

A series of Supreme Court opinions, most predating *Chevron*, strongly imply otherwise⁷⁷ by consistently showing deference to the Office's legal position in the context of infringement litigation. Indeed, in the 1939 *Washingtonian* case, it even credited views⁷⁸ made public only after the case had been argued.⁷⁹

Likewise, in *Mazer*, the Court said: "As a standard we can hardly do better than the words of the present Regulation"⁸⁰ Relying on that regulation, it upheld the validity of copyright in statuettes despite plaintiff's apparent intention to turn most of them into lamps⁸¹ and defendant's claim that they should have therefore been protectable only by design patent.⁸²

Soon thereafter, in *DeSylva*,⁸³ the Court faced the questions of whether, following an author's demise, a surviving spouse shared renewal rights with children and, if so, with illegitimate children.⁸⁴ While it did not defer, the Court stated:

The practice of the Copyright Office has been to register renewal claims by children during the lifetime of an author's widow or widower, although this practice, it is frankly admitted, is more the result of a decision that there is substantial doubt over the question, rather than the result of a confident interpretation of the statute Although *we would ordinarily give weight to the interpretation of an ambiguous statute by the agency charged with its administration*, we think the Copyright Office's explanation of its practice deprives the practice of any force as an interpretation of the statute, and we therefore do not rely on it in this instance.⁸⁵

⁷⁷ *Washingtonian*, 306 U.S. at 41; *Mazer*, 347 U.S. 201 at 213; *DeSylva v. Ballentine*, 351 U.S. 570, 577-78 (1956); *Raquel*, 531 U.S. at 952.

⁷⁸ 306 U.S. at 41 n.4 (quoting a letter from the Register to the Librarian).

⁷⁹ *Id.* at 54 (Black, J. dissenting).

⁸⁰ 347 U.S. at 214; *see also id.* at 212 (referring to the regulation as a "contemporaneous and long continued construction of the statutes by the agency charged to administer them").

⁸¹ *Id.* at 203 ("The sales in lamp form accounted for all but an insignificant portion of respondents' sales.").

⁸² *Id.* at 215.

⁸³ 351 U.S. 570.

⁸⁴ 351 U.S. at 572-73; *see also id.* at 580 (addressing the further question of whether state or federal law controlled on the issue of legitimacy).

⁸⁵ *Id.* at 577-78 (citation omitted) (emphasis added).

In the context of the first sentence, the second implies consequences seemingly contrary to the Second Circuit's later application of the case⁸⁶ because the language in *DeSylva* suggests that deference would have been accorded except for the agency's articulated reluctance to do more than adopt a default position. When the Office, itself, regards an issue as beyond its delegated authority,⁸⁷ that alone provides ample reason not to defer.⁸⁸

In *Raquel*,⁸⁹ the latest case in the Office promulgating rules series, the matters at issue were well within the Office's core competence. As recounted by the Register, her views were accorded controlling weight despite belated clarification:

[T]he Third Circuit had dismissed Raquel's copyright infringement suit based on its conclusion that Raquel had made misrepresentations of material facts in its application The Office concluded that the court had misunderstood the Copyright Office's registration practices. To clarify what those practices are, it published a Statement of Policy in the Federal Register The Office worked with the Department of Justice to prepare an *amicus curiae* brief . . . , and we urged that the Supreme Court grant *certiorari*, but

⁸⁶ See e.g. *Bartok v. Boosey & Hawkes, Inc.*, 523 F.2d 941, 946-47 (2d Cir. 1975) ("[T]he Copyright Office has no authority to give opinions or define legal terms and its interpretation on an issue never before decided should not be given controlling weight." (Notes omitted)); see also *Morris v. Bus. Concepts, Inc.*, 259 F.3d 65, 71 (2d Cir. 2001) (quoting above *Bartok* quote). In a clarification of the latter opinion, however, the court seemed more inclined to credit *Mead, Chevron* and *Skidmore* (see *Mead*, 533 U.S. at 228-29) despite evaluating the Office's views in the context of collateral review. *Morris v. Bus. Concepts, Inc.*, 283 F.3d 502, 503, 505-06 (2d Cir. 2002). See also *Marascalco v. Fantasy, Inc.*, 953 F.2d 469 (9th Cir. 1991), *cert. denied*, 504 U.S. 931 (1992). Here, the Ninth Circuit concluded that "the Register has the authority to interpret the copyright laws and that its interpretations are entitled to judicial deference if reasonable." *Id.* at 473. In doing so, it agreed with *Cablevision Sys. Dev. Co. v. Mot. Picture Assn. of Am., Inc.*, 836 F.2d 599, 609-10, n. 16 (D.C. Cir. 1988) that the just-quoted statement in *Bartok* was unsupported dicta.

⁸⁷ Under the 1909 Act, the Register's authority was limited by § 207 to "rules and regulations for the registration of claims to copyright." Pub. L. No. 61-281, § 207, 61 Stat. 652, 666 (1947) (amending Pub. L. No. 35-349, 35 Stat. 1075 (1909)) (§ 207 has been incorporated into revised Title 17. See 17 U.S.C. §702 (2000)).

⁸⁸ E.g. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543, 1549-50 (Fed. Cir. 1996) ("As we have previously held, the broadest of the PTO's rulemaking powers—35 U.S.C. §6(a)—authorizes the Commissioner to promulgate regulations directed only to 'the conduct of proceedings in the [PTO]'; it does NOT grant the Commissioner the authority to issue substantive rules.") (emphasis added); see also *Digital Equip. Corp. v. Diamond*, 653 F.2d 701, 726 (1st Cir. 1981) (chiding the PTO for addressing issues outside its areas of "unique expertise"); Cf. Pub. L. No. 61-281, § 207, 61 Stat. 652, 666 (1947) (amending Pub. L. No. 35-349, 35 Stat. 1075 (1909)) (§ 207 has been incorporated into revised Title 17. See 17 U.S.C. §702 (2000)).

⁸⁹ *Raquel v. Educ. Mgt. Corp.*, 531 U.S. 952 (2000).

immediately vacate the decision below and remand The Court followed that recommendation.⁹⁰

Thus, once the Office makes its position known on matters central to its authority, its views should not be disregarded simply because courts disagree.

Consider *Bibbero*,⁹¹ for an example where this proposition was not followed. The Ninth Circuit, apparently finding an Office rule consistent with its position,⁹² nevertheless invalidated copyright in a medical insurance claim form.⁹³ Because the Court stated that it “agree[d] with the district court that cases interpreting the blank forms rule do not yield a consistent line of reasoning,”⁹⁴ it seems to have differed in interpreting the rule, something no more defensible than ignoring it.⁹⁵ The Court was unclear if it believed an examiner registered the work in error. Yet, *Bibbero* was later followed,⁹⁶ if reluctantly,⁹⁷ where examiner error seemed unlikely.⁹⁸

Such cases illustrate a primary virtue of deference to agencies’ legal positions: It minimizes conflicts that, until resolved by the Supreme Court, encourage forum shopping and other untoward effects.⁹⁹ Moreover, one must

⁹⁰ United States Copyright Office, *Statement of Marybeth Peters The Register of Copyrights before the Subcommittee on Courts, the Internet, and Intellectual Property Committee on the Judiciary* § V <www.copyright.gov/docs/regstat5201.html> (May 2, 2001).

⁹¹ *Bibbero Sys., Inc. v. Colwell Sys., Inc.*, 893 F.2d 1104 (9th Cir. 1990).

⁹² *Id.* at 1106-07.

⁹³ *Id.* at 1108.

⁹⁴ *Id.* at 1107 (citations omitted).

⁹⁵ See *Auer*, 519 U.S. at 461-62 (holding that Court will defer to an agency’s interpretation of its own regulations unless “plainly erroneous or inconsistent with the regulation.”); see also *Marascalco*, 953 F.2d at 473 (Ninth Circuit concluded that “the Register has the authority to interpret the copyright laws and that its interpretations are entitled to judicial deference if reasonable”). Perhaps in the future, the Ninth Circuit will show more deference in such circumstances.

⁹⁶ *Advanz Behavioral Mgt. Resources, Inc. v. Miraflor*, 21 F. Supp. 2d 1179, 1189 (C.D. Cal. 1998).

⁹⁷ See *id.* at 1186 (citing *Satellite Broad. & Commun. Assn. of Am. v. Oman*, 17 F.3d 344, 347-348 (11th Cir. 1994), which notes that the “Copyright Office’s interpretation of statute and regulations [are] entitled to deference”). Although *Satellite Broadcasting* did not involve registration, it is remarkable for deferring to an Office rule despite circuit precedent to the contrary. *Id.* at 346-48.

⁹⁸ *Miraflor*, 21 F. Supp. 2d at 1181, 1192 (One of the forms in a set had been refused individual registration, suggesting that all the forms received more than superficial attention).

⁹⁹ The Office is also placed in the awkward position of registering works that it knows will be found invalid in some jurisdictions. See United States Copyright Office, § 605.05

consider that copyrights, once found invalid, are doomed; collateral estoppel bars any further chance of enforcing them.¹⁰⁰

III. COPYRIGHT EXAMINATION AND NONSTATUTORY REVIEW OF REFUSALS TO REGISTER

A. *Prior to 1978*

Registration necessarily determines whether forms are complete, fees are ample and the correct identifying materials have been submitted; but the Office has long screened works on the merits.¹⁰¹ Indeed, in 1958, it was proposed that obscene works be refused registration.¹⁰² Although the Attorney General, when asked, hedged with regard to the Register's *authority* to refuse,¹⁰³ he unequivocally concluded that the Office had no *duty* to examine on such grounds,¹⁰⁴ particularly in light of available resources:

The Register has advised me that the facilities of the office make intensive screening of works presented practically impossible. It has a staff of some thirty-five examiners which receives more than 1,000 applications daily. Therefore examination of any more than the question whether the works involved meet the specific statutory requirements of the act may be regarded as not feasible administratively.¹⁰⁵

<www.ipmall.info/hosted_resources/CopyrightCompendium/fplchome.asp> (Where the examination process is carried out using the "rule of doubt." When, "there is a reasonable doubt about the ultimate action which might be taken . . . by an appropriate court" the Office may nevertheless register). *But cf.* Thomas G. Field, Jr., *Review of PTO Intramural Appeal Procedures*, 33 IDEA 117, 119 (1993) (arguing that the Federal Circuit's exclusive jurisdiction, both direct and collateral, over the PTO in patent cases reduces the need for that Court to defer on legal issues).

¹⁰⁰ *Cf. Blonder-Tongue Laboratories, Inc. v. U. of Il. Found.*, 402 U.S. 313, 350 (1971) (so holding for patentees under what were then very similar circumstances).

¹⁰¹ *U.S. ex rel. Everson v. Young*, 26 Wash. L. Rep. 546, 547 (1898) (upholding refusal to register a book of blank forms).

¹⁰² 41 Op. Atty. Gen. 395, 396 (1958).

¹⁰³ *Id.*; *Cf.* 15 U.S.C. § 1052(a) (2000) (explicitly authorizing refusals to register scandalous trademarks); *In re McGinley*, 660 F.2d 481, 484 (CCPA 1981) ("With respect to appellant's First Amendment rights, it is clear that the PTO's refusal to register appellant's mark does not affect his right to use it"). That comment likewise applies to copyrights.

¹⁰⁴ 41 Op. Atty. Gen. at 396.

¹⁰⁵ *Id.* at 401-402.

Despite logistical difficulties and lack of explicit authority, Register's nevertheless felt obliged to refuse uncopyrightable works¹⁰⁶ particularly when defects were obvious from claimant's submissions.¹⁰⁷ For example, few resources were typically needed to identify those who had forfeited protection by failing to provide adequate notice.¹⁰⁸ Moreover, refusing registration of invalid copyrights was helpful both to those who sought it and to the public¹⁰⁹ particularly to people who, believing their rights are protected, learn otherwise after it is too late. For example, if three-dimensional works cannot be protected by copyright, design patents are often available¹¹⁰ but only if applications are filed within one year of certain barring events, including offers to sell.¹¹¹

Apparently because the Office was exceedingly circumspect in refusing,¹¹² Caruthers Berger, in a 1959 study commissioned by the Senate, was unable to find even one case "in which a court has held copyrightable a work which the Copyright Office [has] refused to register on the ground of uncopyrightability."¹¹³ For example, in what seems to be the first reported challenge,¹¹⁴ an applicant sought a writ of mandamus to compel the Librarian to register a book of blank form.¹¹⁵ The judge regarded the Librarian as without

¹⁰⁶ See e.g. Bouve, *supra* n. 18, at 62-64; Arthur Fisher, *The Operations of the Copyright Office* 205 (unpublished ABA Sec. of Pat., Trademark and Copy. L.: Summary of Proc. Wash., D.C. Aug. 26-31, 1960) (copy on file at B. C. L. Lib.) (If the Copyright Office were to register everything submitted "the value of the copyright certificate itself—its prima facie value in court—would be undermined and destroyed. Therefore, I believe this would be an unsound course to pursue").

¹⁰⁷ See e.g. Kaplan, *supra* n. 27, at 41; Berger, *supra* n. 54, at 93-94.

¹⁰⁸ Notice is now permissive, but that was not true until 1988, as 17 U.S.C. § 405(a) (2000) makes clear.

¹⁰⁹ See e.g. Kaplan, *supra* n. 27, at 41; Berger, *supra* n. 54, at 95.

¹¹⁰ See e.g. *Norris Indus.*, 696 F.2d at 919, n. 1.

¹¹¹ 35 U.S.C. § 102(b) (2000) (time-barring events); *Id.* at § 171 (making design patents subject to such provisions).

¹¹² See e.g. Kaplan, *supra* n. 27, at 27-28 (quoting a rule of doubt similar to that in Compendium § 605.05).

¹¹³ Berger, *supra* n. 54, at 95-96.

¹¹⁴ *Id.* at 86-87 (referring to *Everson*, 26 Wash. L. Rep. 546).

¹¹⁵ *Everson*, 26 Wash. L. Rep. at 546; see also United States Copyright Office, *Circular 1a: United States Copyright Office A Brief History and Overview* <www.copyright.gov/circs/circ1a.html> (accessed April 7, 2004) (because *Everson* was decided more than a year after the Office was created (February 19, 1897), it is unclear why relief was sought from Young, the Librarian).

discretion, but, finding the subject matter not “fairly within the purview of the copyright act,” he declined to order the Librarian “to do a vain thing.”¹¹⁶

From that inauspicious beginning, no one seeking direct review ever overcame a merits rejection by seeking mandamus or equivalent.¹¹⁷ Apparently the last successful challenge on any basis¹¹⁸ occurred in 1941, when Register Bouve was required to register several documents as one:¹¹⁹

[I]n our view the District Court correctly held that the determination made by the Register was reviewable in the present case; that it was founded on a clearly erroneous conclusion of law; that the material deposited by appellee was a book, . . . ; and that it was entitled to registration of its claim of copyright therein, and to issuance of a certificate.¹²⁰

Suggesting the level of error needed to prevail under mandamus, the Court continued:

It is impossible even to find a plausible basis for the Register’s position, upon practical consideration, apart from increased fees. Certainly, the convenience and expedition of the work of his office will not be promoted by making twenty registrations and issuing twenty certificates where one would accomplish the same purpose. Moreover, notice to the world and convenience to other writers would be better accomplished in such a case by a single deposit and a single registration.¹²¹

B. Foundations for Judicial Review Since 1978

Authority for screening on the merits was previously disputed,¹²² but § 410(a) now explicitly authorizes the Office to determine whether works “constitute copyrightable subject matter.” The statute¹²³ also leaves considerable

¹¹⁶ *Everson*, 26 Wash. L.Rep. at 547.

¹¹⁷ *See Berger*, *supra* n. 54, at 95-96.

¹¹⁸ *See Atari Games Corp. v. Oman*, 888 F.2d 878, 890 (D.C. Cir. 1989) (Silberman concurring) (hereinafter *Atari I*).

¹¹⁹ *Bouve v. Twentieth Cent.-Fox Film Corp.*, 122 F.2d 51, 54, 56 (D.C. Cir. 1941).

¹²⁰ *Id.* at 54.

¹²¹ *Id.* at 55.

¹²² Compare *Fisher*, *supra* n. 106, at 205 with *Berger*, *supra* n. 54, at 94 (“The functions of the Register in regard to the registration of claims may be characterized as ministerial. While he has been said to have ‘discretion,’ this must be understood in its context, as referring to the fact that he must construe the statute and exercise judgment in determining whether a particular claim is eligible It has been said that his functions . . . are similar to those of a recorder of deeds, though . . . more difficult because of the complexities of the copyright statute” (footnotes omitted)).

¹²³ 17 U.S.C. § 101 *et seq.*

substantive ambiguity for the Office to resolve in regulations,¹²⁴ a Compendium¹²⁵ and decisions in particular cases.¹²⁶

That works may be refused registration is explicit in § 410(b):

In any case in which the Register . . . determines that . . . the material deposited does not constitute copyrightable subject matter . . . , the Register shall refuse registration and shall notify the applicant in writing of the reasons for such refusal.

Moreover, apparently based on the reasonable assumption that authority to refuse implies power to cancel, a regulation states that cancellation can occur if “no registration should have been made because the work does not constitute copyrightable subject matter”¹²⁷ When that regulation was promulgated, lest it be drawn into *inter partes* disputes better resolved in litigation, the Office stated:

As a rule, a cancellation action will be initiated solely because the Office itself has discovered a material error The Office does not invite, and will generally not respond favorably to, requests to cancel a completed registration by a party other than the owner of copyright.¹²⁸

If rights vest prior to registration,¹²⁹ challenges to cancellations and initial refusals should not vary,¹³⁰ but no challenge to a cancellation has been found. Regardless, intramural review should be available as provided in Compendium § 606.04:¹³¹

If the claim is refused after reconsideration, the head of the appropriate section of the Examining Division sends the applicant written notification of the reasons for refusal. The applicant may again request reconsideration in

¹²⁴ See e.g. 37 C.F.R. § 202.10, (stating what is required of pictorial, graphic and sculptural works to be copyrightable); *Id.* at § 202.11(d) (unprotected subject matter).

¹²⁵ See generally *supra* n. 40. The Office website describes the Compendium as a manual of its personnel. U.S. Copyright Office, *Compendium II: Copyright Office Practice* <www.copyright.gov/compendium> (accessed April 7, 2004). But see e.g. Copyright Office, § 606.01 <www.ipmall.info/hosted_resources/CopyrightCompendium/fplchome.asp> (unregistrable material).

¹²⁶ Unfortunately, decisions in intramural appeals are not readily available, much less in a form easily searched. Some have, however, been provided by the Office. See e.g. *supra* n. 72.

¹²⁷ 37 C.F.R. § 201.7(b) (2004).

¹²⁸ 50 Fed. Reg. 33065, 33066-67 (Aug. 16, 1985); but see *Syntek*, 307 F.3d at 782. discussed *supra* at nn. 66-69.

¹²⁹ See *supra* nn. 5, 13 and accompanying text.

¹³⁰ Cf. *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 482-85 (Fed. Cir. 1985) (addressing the process needed to reexamine an issued patent).

¹³¹ See also 60 Fed. Reg. 21983, 21984 (May 4, 1995) (requiring reconsideration requests to be received within 120 days).

writing. This second appeal must be . . . directed to the Board of Appeals . . .

The Board of Appeals shall consist of the Register of Copyrights, the General Counsel, and the Chief of the Examining Division, or their respective designees. The Board shall consider the second appeal and render a final decision. The designated Chair of the Board of Appeals will write the applicant setting out the reasons for acceptance or denial of the claim. The Appeals Board's decision constitutes final *agency* action.¹³²

If reasonably relied on, such information, despite being in a document described as personnel manual,¹³³ binds typical agencies.¹³⁴ Barring prejudice, it may bind the public.¹³⁵

One question is whether the Office is an "agency." Despite use of the term in the last sentence of Compendium § 606.04 quoted above,¹³⁶ the Office sometimes claims otherwise in rulemaking notices.¹³⁷ One of the last cases dealing with registration based on the 1909 Act,¹³⁸ however, convincingly explains why the Office being located within the Library of Congress should have no bearing, at least for purposes related to registration.¹³⁹

¹³² *Id.* (Emphasis added). The last sentence may be intended to signal that further appeals to the Librarian are not possible. *Cf. Butterworth v. U.S. ex rel. Hoe*, 112 U.S. 50, 64-65 (1884) (finding a Cabinet Secretary to whom the Patent Commissioner reported unable to review his decisions).

¹³³ So described at <www.copyright.gov/compendium/index.html> (accessed May 15, 2003).

¹³⁴ *E.g. In re Kaghan*, 387 F.2d 398, 401 (Cust. & Pat. App. 1967):

While the MPEP is primarily published for internal use, it is also made available to patent applicants and their lawyers as well as to the general public [A]n applicant should be entitled to rely not only on the statutes and Rules of Practice but also on the provisions of the MPEP

See also e.g. Morton v. Ruiz, 415 U.S. 199, 235 (1974) (similarly obligating the Bureau of Indian Affairs).

¹³⁵ *E.g. Fressola v. Manbeck*, 1995 U.S. Dist. LEXIS 9116, **5, 13 (D.D.C. March 30, 1995) (a requirement published in only the MPEP bound a patent applicant).

¹³⁶ *Supra* n. 132 and accompanying text.

¹³⁷ *See e.g.* 50 Fed. Reg. at 33067 n.17 ("The Copyright Act does not make the Office an 'agency' as defined in the [APA]"); *but see* 5 U.S.C. § 551(a) (defining "agency"); *see also e.g.* 66 Fed. Reg. 37142, 37149 (July 17, 2001):

Although the Copyright Office, located in the Library of Congress and part of the legislative branch, is not an "agency" subject to the Regulatory Flexibility Act, 5 U.S.C. 601-612, the Register of Copyrights has considered the effect of a proposed amendment on small businesses.

¹³⁸ *Eltra Corp. v. Ringer*, 579 F.2d 294, 295 n.3 (4th Cir. 1978) (decided in June of 1978). The 1976 Act did not apply although it became effective Jan. 1, 1978. Pub. L. No. 94-553, § 101, 90 Stat 2541 (1976).

¹³⁹ *Ringer*, 579 F.2d at 300-01 (It cannot be regarded as a holding because the Court did not need to reach the issue, but the conclusion was based on presidential appointment of the

If the Office is an agency for such purposes, as henceforth assumed in this paper, another important question is the extent to which the last sentence of Compendium § 606.04 also binds courts that review refusals.¹⁴⁰ The question warrants more attention than the Office seems to have given it because refusals, aside from becoming final as indicated there, also become literally “final” once the time for intramural reconsideration or appeal has expired.¹⁴¹

Although subject to various exceptions,¹⁴² courts long required that intramural review options be exhausted before they would review.¹⁴³ That changed, however, after the Supreme Court in *Darby*¹⁴⁴ construed the APA¹⁴⁵ to forbid the practice absent a statutory provision or agency rule requiring exhaustion.¹⁴⁶

If intramural appeals are less expensive and offer concomitant prospects for success, as is assumed to be true, failure to exhaust may seem unlikely. Yet, what if an applicant later regrets allowing an opportunity for intramural review to lapse?¹⁴⁷ Should infringement occur later, nothing bars refiling, but loss of a filing date closer to publication would provide substantial motivation¹⁴⁸ to argue that the last sentence of Compendium § 606.04 is not a “rule,”¹⁴⁹ much less one

Librarian under 2 U.S.C. § 136 (2000)); see also *Marascalco*, 953 F.2d at 473 (rejecting an argument that the Office, in contrast with the Library, “is not an agency whose statutory interpretations are entitled to deference . . .”).

¹⁴⁰ *Supra* n. 132 and accompanying text.

¹⁴¹ 60 Fed. Reg. at 21984. Reconsideration requests must be received within 120 days. *Id.*

¹⁴² See e.g. *Wash. Assn. for Television and Children v. F.C.C.*, 712 F.2d 677, 681-82 nn. 5-11 (D.C. Cir. 1983).

¹⁴³ See e.g. *McKart v. U.S.*, 395 U.S. 185, 193-95 (1969) (discussing policies behind the requirement).

¹⁴⁴ *Darby v. Cisneros*, 509 U.S. 137 (1993).

¹⁴⁵ 5 U.S.C. § 704 provides: “Except as otherwise expressly required by statute, agency action otherwise final is final for the purposes of this section, . . . or, unless the agency otherwise requires by rule . . . an appeal to superior agency authority.”

¹⁴⁶ *Darby*, 509 U.S. at 154. But, “prudential” bases remain. *Id.* at 146. Also, courts cannot review when the record is incomplete. See e.g. *Citizens to Preserve Overton Park, Inc. v. Volpe*, 401 U.S. 402, 420 (1971): “[S]ince the bare record may not disclose the factors that were considered or the Secretary’s construction of the evidence it may be necessary . . . to require some explanation . . . to determine if . . . the Secretary’s action was justifiable under the applicable standard.”

¹⁴⁷ *Cf. McKart*, 395 U.S. at 196-97 (where the Court stated, “[w]e are not here faced with a premature resort to the courts—all administrative remedies are now closed to petitioner”).

¹⁴⁸ *Cf. e.g. Morris*, 259 F.3d at 68 n.1 (discussing possible use of another’s registration to the same end).

¹⁴⁹ *But cf. Fressola*, 36 U.S.P.Q.2d (BNA) 1211 (suggesting otherwise).

that *requires* “an appeal to superior agency authority.”¹⁵⁰ Those arguments should fail, however, when additional intramural consideration is apt to offer a more complete explanation of the Office’s position, even if the ultimate issue is beyond its authority.¹⁵¹

C. Nonstatutory Review Since 1978

As with mandamus review discussed above,¹⁵² APA review is regarded as “nonstatutory.”¹⁵³ Because both are trumped by statutory review,¹⁵⁴ § 411 review is unavailable unless a work is alleged to be infringed at the time registration is denied, although § 411(a) might be seen allow otherwise.¹⁵⁵ Moreover, in at least one instance, APA review was permitted despite a simultaneous challenge under 17 U.S.C. § 411.¹⁵⁶

¹⁵⁰ APA § 704, quoted *supra* at n. 145.

¹⁵¹ See *Oddzon*, 924 F.2d at 350. Although the Court did not refer explicitly to exhaustion, it stated:

In its brief on appeal, however, OddzOn added a footnote raising “a point admittedly not raised heretofore.” OddzOn called our attention to *Gay Toys, Inc. v. Buddy L. Corp.*, 703 F.2d 970 (6th Cir. 1983), a decision holding that a toy airplane is not a “useful article” and therefore is protectable, if minimally creative, without first passing a separability test. Because the classification question was not raised in the application proceedings, that question is not appropriately before us for review.

Id. (Note and citation omitted.) Courts may insist on exhaustion even when the agency lacks authority to resolve a disputed issue. See e.g. *Marine Mammal Conservancy, Inc. v. U.S. Dept. Agric.*, 134 F.3d 409, 413 (D.C. Cir. 1998) (“Marine Mammal is very much mistaken in believing that there is some bright-line rule allowing litigants to bypass administrative appeals simply because one or all of their claims are constitutional in nature”).

¹⁵² *Supra* Part III. A and accompanying text.

¹⁵³ See e.g. ACUS Sourcebook, *supra* note 16, at 208 (discussing conventional use of “statutory” and “nonstatutory,” a jurisdictional dichotomy that derives from APA § 703).

¹⁵⁴ See e.g. *Franchi v. Manbeck*, 972 F.2d 1283, 1288-89 (Fed. Cir. 1992) (discussing both the APA and mandamus review).

¹⁵⁵ 17 U.S.C. § 411(a); *Nova Stylings, Inc. v. Ladd*, 695 F.2d 1179, 1181 (9th Cir. 1983) (“We believe that under the 1976 Act mandamus review is no longer available, at least when an infringement has occurred”).

¹⁵⁶ See *Atari I*, 888 F.2d at 881 n.3; see also *Ward*, 208 F. Supp. 2d at 447 n.107 (“[P]laintiff has not asked this Court to compel registration and, . . . the notice defect pointed out by the Copyright Office will have no bearing on the ultimate determination of copyright ownership, which requires resolution by the trier of fact”).

If jurisdictional requirements are satisfied,¹⁵⁷ APA § 706 provides for presumptive and comprehensive judicial review of agency decisions.¹⁵⁸ Most broadly:

The reviewing court shall (1) compel agency action unlawfully withheld or unreasonably delayed; and (2) hold unlawful and set aside agency action, findings, and conclusions found to be – (A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law

While it seems unnecessary,¹⁵⁹ APA § 706 also addresses administrative action “contrary to constitutional right, power, privilege, or immunity.”¹⁶⁰ Moreover, it provides that actions are to be set aside if the product of improper procedures,¹⁶¹ “in excess of statutory jurisdiction, authority or limitation, or short of statutory right,”¹⁶² “unsupported by substantial evidence” if a hearing is required¹⁶³ or “unwarranted by the facts to the extent they are subject to trial de novo.”¹⁶⁴

At least with respect to copyright registrations,¹⁶⁵ most of those propositions are untested; only APA § 706(2)(A) (arbitrary-capricious review) has been applied.¹⁶⁶ Of the three cases warranting closest attention, all were resolved over a decade ago. In those cases, two of the three courts offered Atari modest solace in the court's seriatim challenges to refuse registration for a video game as an audiovisual work.¹⁶⁷ The third, decided during the interval between

¹⁵⁷ See APA § 703; see also *supra* nn. 140-51 and accompanying text (regarding finality and exhaustion requirements).

¹⁵⁸ See generally *Overton Park*, 401 U.S. at 415-18 (example of comprehensive judicial review).

¹⁵⁹ *Rydeen*, 748 F.Supp. at 903-04 (discussing de novo review of a decision divesting patent rights without formal administrative process).

¹⁶⁰ APA § 706(2)(B) (could include Fifth Amendment, APA or statutory requirements).

¹⁶¹ *Id.* § 706(2)(D).

¹⁶² APA § 706(2)(C).

¹⁶³ APA § 706(2)(E) (inapplicable because § 410 requires no hearing prior to refusal, much less one conforming to APA § 554).

¹⁶⁴ APA § 706(2)(F). To the extent that a formal hearing might be required because refusals divest rights, the procedural defect might be corrected under that section if a § 411 action cannot be pursued for lack of an existing infringer.

¹⁶⁵ Cf. e.g. *Motion Picture Assn. Am. v. Oman*, 969 F.2d 1154 (D.C. Cir. 1992) (deferring to the Office's choice of rule making over adjudication in a different context).

¹⁶⁶ APA § 706(2)(A). (quoted *supra* following n. 158).

¹⁶⁷ *Atari I*, 888 F.2d 878, *superseded*, *Atari Games Corp. v. Oman*, 979 F.2d 242 (D.C. Cir. 1992) [hereinafter *Atari II*].

the *two Atari* decisions, rejected Oddzon's challenge that its Koosh ball should be registrable as soft sculpture.¹⁶⁸

In *Atari I*, the District Court had awarded summary judgment to the Office.¹⁶⁹ Reviewing that disposition as a matter of law, the Court of Appeals applied the arbitrary-capricious standard¹⁷⁰ as though it had original jurisdiction.¹⁷¹ The Court apparently found no basis for disagreeing with the Office's assessment of the facts or its legal views but expressed regret that the Office had inadequately distinguished between the existence of copyright and its scope.¹⁷² Unable to discern how the Office had applied the law, the Court could not uphold the decision on arbitrary-capricious review without a "rational explanation."¹⁷³

Judge Silberman's concurrence in *Atari I*, however, warrants more attention.¹⁷⁴ He expressed concern that "the majority opinion could be misinterpreted so as to confine improperly the Register's discretion on remand."¹⁷⁵ His problem with the majority opinion was "its implicit, if not explicit, expansion of the scope of our review of the Copyright Office's registration decisions."¹⁷⁶ He noted, too, that "no court since 1941 has reversed a decision by the Register to deny an initial application for a copyright."¹⁷⁷

Without attending to possible differences between APA and mandamus review, he offered these reasons for concern:

We must bear in mind that when we review the Register's determination to accept or reject an application for registration, we do not make a final decision on the copyrightability of the item. In fact, as the majority opinion recognizes, the Copyright Office's imprimatur is worth only a rebuttable presumption as to copyrightability in an infringement action. And as the government points out, the Copyright Office receives over 100,000 applications every year. Every time the Register denies registration for too little creativity it cannot be expected to issue an opinion that compares with the learned offerings of my colleagues. I think that is why the courts have

¹⁶⁸ *Oddzon Prods., Inc.*, 924 F.2d at 350.

¹⁶⁹ 888 F.2d at 880.

¹⁷⁰ APA § 706(2)(A) (quoted *supra* following n. 158).

¹⁷¹ *Atari I*, 888 F.2d at 881.

¹⁷² *Id.* at 882-83.

¹⁷³ *Id.* at 881.

¹⁷⁴ *Id.* at 888 F.2d at 886.

¹⁷⁵ *Id.* at 887.

¹⁷⁶ *Id.* at 888.

¹⁷⁷ *Id.* at 890.

generally thought abuse of discretion to be the appropriate standard to review the Office's denial of a registration.¹⁷⁸

Yet, his observations seem off the mark in several respects. First, while the Office receives a large number of applications, not all are rejected.¹⁷⁹ Moreover, not every rejection is appealed. Hence, fully developed opinions are needed far less frequently than he implied.

More significantly, Judge Silberman did not credit, as indicated in what seems to have been the last case decided under the 1909 Act, that Congress may have intended APA review to be less deferential than challenges under mandamus.¹⁸⁰ Moreover, in accusing the majority of engaging in de novo review,¹⁸¹ he seemed to disregard prior recognition of the flexibility of arbitrary-capricious review,¹⁸² as well as the contours of that review as outlined by the Supreme Court nearly twenty years earlier:

Even though there is no de novo review in this case and the Secretary's [decision] does not have ultimately to meet the substantial-evidence test, the generally applicable standards of § 706 require the reviewing court to engage in a substantial inquiry. Certainly, the Secretary's decision is entitled to a presumption of regularity. But that presumption is not to shield his action from a thorough, probing, in-depth review.¹⁸³

¹⁷⁸ *Id.* at 887.

¹⁷⁹ The exact percentage is unimportant, but, as notice has not been required under 17 U.S.C. § 405(a) since 1988, even fewer rejections would be expected than were reported in the 1950's. *See Berger, supra*, n. 54 at 93; Kaplan, *supra*, n. 27 at 35-6 (referring to a 3% refusal rate for fiscal year 1957).

¹⁸⁰ *Esquire, Inc.*, 591 F.2d at 806 n. 28 (decided in August 1978). The majority also rejected Judge Levental's concurring argument because the issue was "neither briefed nor argued." *Id.* Reduced deference under the APA had been anticipated by some. *See, e.g.*, Casper W. Ooms, *The U.S. Patent Office and the Administrative Procedure Act*, 38 Trademark Rep. 149, 159 (1948) (foreseeing that "courts will welcome the appellant . . . and not merely treat him as a suppliant."); *see also* Attorney General's Manual on the Administrative Procedure Act, 5 (1947) (indicating a desire "to achieve relative uniformity in the administrative machinery of the Federal Government."), reprinted ACUS Sourcebook, *supra* n. 16, at 67, online at <www.law.fsu.edu/library/admin/1947intro.html> (accessed June 18, 2003). In light of such views at the time the APA was enacted, it is difficult to understand why no one challenging refusals to register sought APA review before it became explicitly available in § 701.

¹⁸¹ *Atari I*, 888 F.2d at 889.

¹⁸² *See Am. Horse Protection Assn., Inc. v. Lyng*, 812 F.2d 1, 4 (D.C. Cir. 1987) ("Review under the 'arbitrary and capricious' tag line . . . encompasses a range of levels of deference to the agency.").

¹⁸³ *Overton Park, Inc.*, 401 U.S. at 415 (citations omitted). The contrasted substantial-evidence and de-novo standards appear, respectively, in 5 U.S.C. §§ 706(2)(E) and (F) (discussed *supra* nn. 163-64).

That appears to be precisely the approach taken in both *Atari I* and *Atari II*. Still unable to understand the Office's position, *Atari II* did not order registration; it merely said:

The rational basis for finding the elements as combined and arranged in BREAKOUT "so commonplace that [they have] come to be expected as a matter of course," *Feist*, 499 U.S. at [341], eludes us. It is the Register's duty, as it is ours, to heed the unifying and clarifying instruction furnished by the Supreme Court in *Feist*. Therefore, we [again] reverse the summary judgment granted to the Register and [again] remand the case to the district court with instructions to *again return* the matter of Atari's application to the Register for renewed consideration consistent with this court's opinion.¹⁸⁴

Moreover, the intervening decision in *Oddzon* suggests the D.C. Circuit had meant what is said about the scope and focus of APA review¹⁸⁵ when it found the basis for the Office's reasons were not "similarly opaque."¹⁸⁶

Those opinions are consistent with the Supreme Court's rejection of the Federal Circuit's refusal to apply APA § 706(2) standards when reviewing decisions by the Patent and Trademark Office (PTO) under a statute that is silent with regard to standards of review.¹⁸⁷ After the Federal Circuit had indicated no need to defer to agency reasoning,¹⁸⁸ the Supreme Court reversed and pointed out key differences between court-court review and court-agency review.¹⁸⁹ The focus of court-agency review, it held, should be agencies' reasoning.¹⁹⁰

Taking that to heart, Judge Newman later wrote:

For judicial review to be meaningfully achieved . . . , the agency tribunal must present a full and reasoned explanation of its decision. The agency tribunal must set forth its findings and the grounds thereof, as supported by the agency record, and explain its application of the law to the found facts.¹⁹¹

The contrast with mandamus review, however, seems stark. Applicants are required to show a lack of "plausible basis"¹⁹² or that the decision is "outside

¹⁸⁴ *Atari II*, 979 F.2d at 247 (emphasis added).

¹⁸⁵ *Oddzon Corp., Inc.*, 924 F.2d at 350 (refusing to entertain an issue "not raised in the application proceedings").

¹⁸⁶ *Id.* at 349.

¹⁸⁷ *Dickinson v. Zurko*, 527 U.S. 150, 164 (1999) (regarding 35 U.S.C. § 141) [hereinafter *Zurko II*].

¹⁸⁸ *In re Zurko*, 111 F.3d 887, 889 (Fed. Cir. 1997).

¹⁸⁹ *Zurko II*, 527 U.S. at 161-62.

¹⁹⁰ *Id.* at 165.

¹⁹¹ *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002).

¹⁹² *Bouve*, 122 F.2d at 55 (quoted *supra*, n. 121).

the bounds of 'any rational exercise of discretion',¹⁹³ is to impose a heavy burden. It seems reasonable to ask, instead, that the Office provide reasons¹⁹⁴ that, at least in the case of refusals, can withstand "thorough, probing, in-depth review."¹⁹⁵

IV. HYBRID REVIEW

A. Section 411: Genesis and Legislative History

In 1958, the Second Circuit had occasion to consider the alleged infringement of copyright in an ornate watch.¹⁹⁶ Assuming, *arguendo*, that the watch was copyrightable,¹⁹⁷ the majority concluded that, without a registration certificate,¹⁹⁸ it lacked jurisdiction and affirmed dismissal.¹⁹⁹

In his celebrated dissent, Judge Clark said that he regarded the refusal to register as "purely a ruling of law which was erroneous and beyond the authority of the official making it."²⁰⁰ Judge Clark also doubted:

if the ministerial grant of a certificate is a condition precedent to a suit for copyright; but however this question is answered, it seems to me clear that a plaintiff situated as is this one is entitled to at least interim relief against a defendant wrongdoer over whom the court has obtained jurisdiction. The plaintiff should at any rate have an injunction preventing further wrongdoing until it is able to seek mandamus against the Register in the District of Columbia.²⁰¹

Unfortunately, as the last sentence of the quoted dissent indicates, the Court also lacked mandamus jurisdiction.²⁰²

¹⁹³ *Esquire, Inc.*, 591 F.2d at 806 n. 28 (quoting *U.S. v. Commanding Off. Armed Forces*, 403 F.2d 371, 374 (2d Cir. 1968)).

¹⁹⁴ No reasons are usually available for collateral review. *See supra*, n. 69-73.

¹⁹⁵ *See Overton Park, Inc.*, 401 U.S. at 415; *see also id.* at 419 (eschewing "'post hoc' rationalizations").

¹⁹⁶ *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637, 639 (2d Cir. 1958).

¹⁹⁷ *Id.* at 639.

¹⁹⁸ *Id.* at 640-41.

¹⁹⁹ *Id.* at 641-42.

²⁰⁰ *Id.* at 644.

²⁰¹ *Id.* at 644-45.

²⁰² Regarding the last sentence, *see* 28 U.S.C. § 1361, added by Pub. L. No. 87-748, § 1(a) (Oct. 5, 1962) 76 Stat. 744: The district courts shall have original jurisdiction of any action in the nature of mandamus to compel an officer or employee of the United States or any agency

Soon thereafter, then-Register Fisher rejected a suggestion that the Office cease conducting merits examination.²⁰³ He went on to endorse an alternative:

The course that does appeal to me . . . is to prepare legislation along the line recommended by Judge Clark . . . namely, that the plaintiff should be able to proceed in an infringement action in his local jurisdiction In [a] meeting this morning, this was the essential recommendation.

There has been a further suggestion that perhaps there should be an appeal in copyright to the Court of Customs and Patent Appeals . . . but . . . the principles of copyright and the principles of patent are so different that perhaps one should hesitate to mix them.

Furthermore, to require an appeal to a specialized court here in Washington would also make it necessary for a plaintiff out in the country to come to Washington, necessitating further delay, and I am not sure in the long run it would be as effective as the procedure recommended by Judge Clark.²⁰⁴

In that vein, the Committee Report accompanying the 1976 Act states that the second and third sentences of § 411(a) were drafted to "alter the present law as interpreted in" *Vacheron* by permitting a rejected applicant who has properly applied²⁰⁵ to nevertheless maintain an infringement suit.²⁰⁶ Those sentences provide:

In any case, however, where the deposit, application, and fee required for registration have been delivered to the Copyright Office in proper form and registration has been refused, the applicant is entitled to institute an action . . . if notice thereof, with a copy of the complaint, is served on the Register of Copyrights. The Register may, at his or her option, become a party . . . , but the Register's failure to become a party shall not deprive the court of jurisdiction.²⁰⁷

thereof to perform a duty owed to the plaintiff. See also *e.g. Nova Stylings, Inc.*, 695 F.2d at 1180 (finding § 1361's primary purpose to have been expanding "the scope of venue in a mandamus action beyond the District of Columbia").

²⁰³ Fisher, *supra*, n. 106.

²⁰⁴ *Id.* at 205

²⁰⁵ *Cf. Proulx*, 1981 WL 1397 at *4 ("plaintiff's application was not in proper form and his application was not 'refused' within the meaning of § 411(a)"); *cf. id.* at *7 (describing that as a failure to exhaust administrative remedies, but this seems well outside normal use of exhaustion terminology).

²⁰⁶ H.R. Rpt. 94-1476 at 157 (Sept. 3, 1976) (reprinted in 1976 U.S.C.C.A.N 5659, 5773).

²⁰⁷ 17 U.S.C. § 411(a). Regarding its basic requirements, see *Sadler-Cisar, Inc. v. Commercial Sales Network, Inc.*, 786 F. Supp. 1287, 1297 (N.D. Ohio 1991) (dismissing for lack of notice to the Register) and *supra* n. 205.

Had mandamus jurisdiction been available in the Second Circuit at the time of *Vacheron*,²⁰⁸ and had the entire panel regarded the Register's decision as unsupportable, the Court might well have ordered registration or proceeded as if that had already occurred.²⁰⁹ Particularly when construed in light of Fisher's endorsement²¹⁰ of what became the last two sentences of § 411(a), legislative history implies that those sentences were intended only to offer such options.²¹¹

The first sentence merely continued the longstanding registration requirement, but it was altered when the United States joined the Berne Convention in 1988:

After considering extensive testimony and submissions on this topic, the committee has concluded that section 411(a) in its current form is incompatible with Article 5(2) of Berne. The committee recognizes that this conclusion is not free from doubt, but on the record before it, the committee is persuaded that the requirement of registration as a prerequisite to an infringement lawsuit is a prohibited formality. On the other hand, it has concluded that the statutory incentives for registration contained in the provisions of sections 410(c), 412, and 205 of the Copyright Act are not preconditions for the "enjoyment and exercise" of copyright. While those provisions substantially enhance the relief available to the proprietor of a registered work, they do not condition the availability of all meaningful relief on registration, and therefore are not inconsistent with Berne.²¹²

Although no amendment to the remainder of § 411(a) was needed to accomplish those legislative goals, the Senate Report also said:

The exception in section 411(a) for claims which the Copyright Office has refused to register ameliorates the situation somewhat in a handful of cases. ([Register Oman] reported to the Subcommittee that, "over the past five years, [it] has been served with a copy of a complaint under section 411(a) in thirteen cases," in eleven of which it entered an appearance.) . . . The exception to section 411(a) merely provides that the Office must be accorded a second opportunity to express its views . . . if it has refused to recognize the claim before the suit is filed. *Of course, the court is not bound by the views expressed by the Register in a case in which suit is filed despite his refusal to register the claim. But the same is true in any infringement lawsuit.*

The fact remains that, in each of the thousands of copyright infringement lawsuits filed . . . since present section 411(a) was enacted, a review by the Register . . . has been a necessary precondition for enforcement.²¹³

²⁰⁸ It became available only four years later. See *supra* n. 202.

²⁰⁹ See *supra* n. 197 (the majority merely assumed that the work was copyrightable).

²¹⁰ Quoted at *supra* n. 204.

²¹¹ Quoted at *supra* n. 206.

²¹² Sen. Rpt. 100-352 at 14-15 (May 20, 1988) (reprinted in 1988 U.S.C.C.A.N. 3706, 3719 – 720).

²¹³ *Id.* at 14 n. 2 (emphasis added).

No authority is cited for the italicized language. Rather than reflecting a new, or even a current, view of § 411(a), it is more likely to express a view of the Register's authority commonly held²¹⁴ prior to the availability of explicit statutory authority to examine, in § 410(a), and to refuse, in § 410(b).

Caruthers Berger, for example, wrote in 1959 that the Register "has no quasi-judicial functions"²¹⁵ and characterized his authority as "ministerial."²¹⁶ Yet that view, if prominent, was hotly disputed by Registers²¹⁷ and is inconsistent with the fact that the Office had never been compelled to register a work that it had rejected on the merits.²¹⁸

While courts inclined to review *de novo* under § 411²¹⁹ might be tempted²²⁰ to regard the Committee's remark²²¹ as legally significant, it is more

²¹⁴ Discussed *supra* nn. 122-27.

²¹⁵ Berger, *supra* n. 54, at 94.

²¹⁶ *Id.* (quoted more fully *supra* n. 122). What she meant by "ministerial" is not entirely clear, but the term seems to indicate that registration was regarded as perfunctory. *See also, e.g.,* E. Fulton Brylawski, *The Copyright Office: A Constitutional Confrontation*, 44 Geo. Wash. L.Rev. 1, 12 (1975):

[T]he Copyright Office cannot exercise executive or judicial functions as long as it remains within the legislative branch. If it is to remain within the constitutional confines of a legislative agency, the law requires that it exercise only ministerial powers without any degree of discretion or power of statutory interpretation.

Brulawski's argument, however, was rejected in *Eltra Corp.*, 579 F.2d at 299 (finding it "incredible that, if there were a constitutional infirmity in the 1909 Act, it would have so long escaped notice").

²¹⁷ *See e.g.* Bouve, *supra*, n. 18 at 63-64; Fisher, as quoted *supra* n. 106.

²¹⁸ Berger, *supra* note 54, at 95-96.

²¹⁹ *See e.g. Allied Materials & Equip. Co.v. Pappa Geppetto's Toys Victoria Ltd.*, 28 U.S.P.Q.2d (BNA) 1862, 1864-65 (D. Kan. 1993); *Ward*, 208 F. Supp. 2d at 444-45.

²²⁰ *See e.g.* Paul Goldstein, *The Case for and against 17 U.S.C. § 411(a)*, Working Paper No. 2, ACCORD REPORT, *supra*, n. 35 at A/62, A/70 (1993):

Few copyright owners would object to registration as a condition for suit if the registration process entailed no more than does the recordation process of transfer of real property titles . . . Registration under these conditions would be strictly *pro forma* and an acceptable incident to the costs of litigation generally.

He went on to observe, "[S]ection 411(a)'s requirement that copyright owners traverse a Copyright Office examination as a condition of vindicating their claim is entirely without justification." *Id.* at A/71. An alternative is described by Martin J. Beran, *Refusals to Register—A Roadblock to Copyright Owners*, 10 Bull. Copyright Society of the U.S.A. 147, 162-63 (1963) (proposing issuance of "Certificates of Administrative Compliance"). *But see* Peter Jaszi, Working Paper. No. 2a, ACCORD REPORT, A/72, A/73: "Even if one believes

appropriately regarded as legislative dicta—a post-enactment pronouncement having little, if any, interpretive value.²²² Moreover, as demonstrated below, prior judicial interpretations of the last two sentences of § 411(a) cannot support the proposition that reenactment of that language amounted to congressional ratification.²²³

B. Early Cases Reviewing Refusals under § 411

Five years after § 411 became effective, the first opinion of apparent significance was written by the Eleventh Circuit in *Norris Industries*.²²⁴ Citing *Mazer*²²⁵ and *Esquire*,²²⁶ it approved deference to a refusal to register an ornate hubcap:

These determinations are routinely made by the Register and are unquestionably related to the substantive area of the agency's business. Therefore, we find no error in the district court's reliance on the Register's opinion that Norris' wheel covers are useful articles as that term is used in the Act. This is not to say that the court should simply accept the Register's decision without question. But our view of the uncontradicted evidence and the graphic description of the wheel cover reveals no abuse of administrative discretion.²²⁷

The source of that standard of review is unclear,²²⁸ but other courts²²⁹ have cited the APA in such a context. In *John Muller*, for example, the Eighth

that the courts will always achieve a truly fair balance between proprietors and users in the end, there may be reason to preserve an administrative mechanism which could help to assure that." Further pursuit of that topic, however, is beyond the scope of this paper.

²²¹ Sen. Rpt. 100-352, at 14 n. 2. (quoted *supra* n. 213).

²²² See generally e.g. Ronald Benton Brown & Sharon Jacobs Brown, *Statutory Interpretation: The Search for Legislative Intent*, 147 (Nat'l. Inst. For Tr. Advoc. 2002) (discussing post-enactment legislative events).

²²³ See *id.* at 149.

²²⁴ *Norris Indus.*, 696 F.2d at 922.

²²⁵ 347 U.S. at 209-13.

²²⁶ 591 F.2d at 805-06, n. 28.

²²⁷ *Norris Indus.*, 696 F.2d at 922.

²²⁸ But see APA § 706(2)(A)(quoted *supra* following n. 158).

²²⁹ *John Muller & Co. v. N.Y. Arrows Soccer Team, Inc.*, 802 F.2d 989, 990 (8th Cir. 1986).

Circuit cited the APA in concluding that "[t]he Register's decisions are subject to judicial review, but only on an abuse of discretion standard."²³⁰

Meanwhile, Judge Weingeld in *Gemveto Jewelry*²³¹ had likewise reviewed a refusal under § 411 as though it was, instead, filed under the APA:

[D]eterminations of the Copyright Office . . . are entitled to "considerable" weight. . . . Moreover, the decision to register an article rests in the sound discretion of the Register of Copyrights, and the scope of judicial review is limited to whether the decision was "arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law."²³²

Yet, the standard made little difference. *Gemveto* had already forfeited all copyright otherwise available²³³ by failing to provide notice at the time of publication or to take other measures to "rectify the omission."²³⁴

The Second Circuit in *Carol Barnhart* muddled the waters two years later when it considered a collateral challenge to the copyrightability of a registered work.²³⁵ Lacking evidence of why a certificate had issued, it appropriately relied on *Durham Industries*²³⁶ to conclude that "it is permissible for the district court itself to consider how the copyright law applies to the articles under consideration."²³⁷ Unfortunately, the Court seems not to have appreciated differences in the records available for reviewing certificates and refusals, appearing to regard its approach as conflicting with that of the Eleventh Circuit in *Norris Industries*.²³⁸

²³⁰ 802 F.2d at 990 (citing APA §§ 701, 706(2)(A)). See also *Norris Indus.*, 696 F.2d at 922. If evaluation of the Office's position under § 411 can be regarded as administrative review, then APA standards presumptively apply. See *Dickinson*, 527 U.S. at 165:

Neither the Circuit nor its supporting amici, however, have explained convincingly why direct review of the PTO's patent denials demands a stricter fact-related review standard than is applicable to other agencies. Congress has set forth the appropriate standard in the APA. For the reasons stated, we have not found circumstances that justify an exception.

²³¹ *Gemveto Jewelry Co. v. Jeff Cooper, Inc.*, 568 F. Supp. 319 (S.D.N.Y. 1983) [hereinafter *Gemveto I*]. Other issues were pursued on appeal, but the copyright issue was dropped. See *Gemveto Jewelry Co. v. Jeff Cooper, Inc.*, 800 F.2d 256 (Fed. Cir. 1986).

²³² *Gemveto I*, 568 F. Supp. at 329-30 (citing mandamus cases as well as, at n. 48, APA § 706).

²³³ *Id.* at 331.

²³⁴ *Id.*

²³⁵ *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411 (2d Cir. 1985).

²³⁶ 630 F.2d at 908 (quoted and discussed *supra* nn. 55-60).

²³⁷ *Carol Barnhart Inc.*, 773 F.2d at 414.

²³⁸ *Contra Norris Industries Inc.*, 696 F.2d at 922 (quoted and discussed *supra* nn. 224-27).

The following year, Judge Haight²³⁹ also saw tension between the deferential standard used by his colleague in *Genveto I*²⁴⁰ and the de novo standard used by the Appellate Court in *Carol Barnhart*.²⁴¹ Judge Haight, in *Brandir International*, however, chose to avoid and stated "whether I consider the matter with deference or de novo, I conclude that the Copyright Office was clearly correct in rejecting Brandir's application to register its bicycle rack."²⁴²

On appeal, the Second Circuit may have agreed.²⁴³ In any event, perhaps because the Register chose to join the suit,²⁴⁴ the Court made no reference to the basis for his refusal or to the standard of review.

Not until 1989, did any judge confront the differences between collateral and direct review under § 411—and that by way of dicta in Judge Silberman's concurrence in *Atari I*.²⁴⁵ He acknowledged that, while the Office typically does not explain why it registers, it is obligated to explain refusals under § 410(c).²⁴⁶ Yet, without citing § 411, much less its legislative history or any case applying it to a refusal, Judge Silberman opined that "deference is unwarranted in an infringement action, which, of course, is not a direct review of agency action governed by the [APA]."²⁴⁷ Thus, despite acknowledging the difference between direct and collateral review under § 411, he went on to conclude that, outside the context of APA review, "judicial review of questions of law, including the question of copyrightability, is otherwise entirely de novo."²⁴⁸

²³⁹ *Brandir Intl., Inc. v. Cascade Pacific Lumber Co.*, 1986 WL 12107 (S.D.N.Y. 1986).

²⁴⁰ 568 F. Supp. at 329-30 (citing mandamus cases as well as, at n. 48, APA § 706).

²⁴¹ *Carol Barnhart Inc.*, 773 F.2d at 414.

²⁴² 1986 WL 12107 *3.

²⁴³ *Brandir Intl., Inc. v. Cascade Pacific Lumber Co.*, 834 F.2d 1142 (2d Cir. 1987).

²⁴⁴ Registers also joined *Norris* (Ladd), 696 F.2d 918, and *Muller* (Oman), 802 F.2d 989, but apparently not *Genveto*, 568 F. Supp. 319. That seems to have little if any influence on outcomes.

²⁴⁵ 888 F.2d at 887. *Cf. supra* n. 222; the date, 1989, is therefore notable because this, the first such attempt, it followed publication of S. Rep. 100-352 (quoted *supra* 213).

²⁴⁶ 888 F.2d at 887 n.1.

²⁴⁷ *Id.* at 887 (emphasis omitted). *See also id.* at 889:

It may well be that if this issue came to us . . . in an infringement action as it did [in a Fourth Circuit case], as an infringement action in which the court was not obligated to defer to an agency's action or interpretation, I would follow the Fourth Circuit's approach . . .

Those observations were cited with apparent approval in *Oddzon*, 924 F.2d at 348 and 350 n. 6, but, because both cases reviewed under the APA, they were dicta in both cases.

²⁴⁸ 888 F.2d at 887.

His conclusion is surprising: essentially unavoidable lack of deference²⁴⁹ to the Office's views when they *are not* available²⁵⁰ lays scant foundation for ignoring them when they *must be*²⁵¹—regardless of whether direct review is under § 411(a) or the APA. Moreover, although Judge Silberman relied heavily on *Durham*,²⁵² the Second Circuit has since retreated from its position in that case, acknowledging that deference to the Office's legal views is required even in the context of collateral proceedings.²⁵³

C. Recent Cases and the Process Dimension

Responding to one intramural appeal, the Copyright Board of Appeals indicated that it would register six of nine toys if the applicant would resubmit and “limit[] the claims to copyrightable elements.”²⁵⁴ It refused, however, to register the remaining three toys for lack of originality, even as a compilation, because “[a]ny compilation consisting of less than *four selections* is considered to lack the requisite original authorship.”²⁵⁵ Whether the Office's four-selections test, designed for non-dramatic literary works,²⁵⁶ should be applied to toys²⁵⁷ is far from clear. The need for examination at that depth may be even less clear²⁵⁸—particularly when the Office seems to conflate novelty and originality.²⁵⁹

²⁴⁹ Cf. *Syntek Semiconductor*, 307 F.3d at 781 (discussed *supra* nn. 66-68). Little can be made, however, of one such referral under seemingly unique circumstances.

²⁵⁰ See *supra* nn. 72, 73.

²⁵¹ 17 U.S.C. § 410 (c).

²⁵² 888 F.2d at 887.

²⁵³ *Morris*, 259 F.3d at 71.

²⁵⁴ *Re Learning Curve Toys*, 1 (Copy. Off. App. Bd. Aug. 11, 1999).

²⁵⁵ *Id.* at 7 (emphasis added).

²⁵⁶ *Compendium II* § 307.01.

²⁵⁷ Cf. *Lamps Plus, Inc. v. Seattle Lighting Fixture Co.*, 345 F.3d 1140, 1146-47 (9th Cir. 2003). The Court cited *Compendium II* § 307.01 but seemed to rely more on *Satava v Lowry*, 323 F.3d 805, 811 (9th Cir. 2003). The latter, however, was similar to *Ets-Hoskin*, 225 F.3d 1068 (cited by *e.g. Satava* at 810 n.3) and turned on an entirely different point—the scope of protection in light of the difference between unprotected ideas and protected expression.

²⁵⁸ This seems to typify what Paul Goldstein had in mind when he said, *supra* note 220, at A/71: “Part of the problem [with the requirement for registration prior to suit] lies in . . . the Copyright Office's occasionally evident “Patent Office mentality” of resolving doubts against applicants.”

²⁵⁹ To the extent that a difference exists, novelty might be regarded as determined objectively, and originality as determined subjectively. See *e.g. Mazer*, 347 U.S. at 217-18; while *Feist*

Positing for purposes of this paper that such examination is warranted, the question of deference nevertheless remains. The need for courts to credit the Office's capacity to resolve subject matter issues as a matter of law²⁶⁰ should not imply a need to accept attempts to resolve fact-sensitive issues with per se rules²⁶¹ or to defer to its fact-finding.²⁶² Especially when critical fact issues cannot be evaded with per se rules, it is difficult to see how document evaluation alone²⁶³ provides sufficient process to deny potentially significant benefits of registration,²⁶⁴ much less to divest ownership or copyright.²⁶⁵

Because virtually nothing has been found to address such issues in the copyright arena,²⁶⁶ some consideration of patents and trademarks is useful because administrative decisions are also subject to both direct and collateral review. If "not identical twins," patents and copyrights are closer in constitutional terms.²⁶⁷ Yet, because trademark rights, remote constitutionally,²⁶⁸ also exist despite registration, they furnish a more apt process analogy if registration, rather than validity, determinations are considered:

Every right a patentee has is given to him by the Patent Office. On the other hand, the acquisition of the right to exclude others from the use of a trademark results from the fact of use and the common law, independently of registration in the Patent Office. The happenstance that trademarks are

Publications, Inc. v. Rural Telephone Service Co., Inc., 499 U.S. 340 (1991) casts doubt on *Mazer's* reference to directories, the rest seems current. *But see Lamps Plus* 345 F.3d 1140.

²⁶⁰ See *supra* nn. 76-90.

²⁶¹ See e.g. *Natl. Petroleum Refiners Assn. v. FTC*, 482 F.2d 672, 679-80 (D.C. Cir. 1973) (discussing a variety of authority in a particularly interesting context).

²⁶² *Paul Morelli Design*, 200 F. Supp. 2d at 482.

²⁶³ See *id.* at 485, and discussed more fully *infra*. While more evidence may sometimes be considered, such consideration is no substitute for a hearing. See e.g. *Re Flanders Brilliant Cut Diamond*, (Copy. Off. App. Bd. Nov. 6, 2001) (indicating that a replica of a gemstone had been provided to the Office when questions were raised).

²⁶⁴ See 17 U.S.C. § 410(c) (prima facie evidence of validity if registration is obtained within five years) and § 412 (statutory damages if registration is obtained within three months of publication, or before infringement in the case of unpublished works). See also §§ 602, 603; while those sections do not explicitly require registration, see *Oddzon Prod. Inc.*, 924 F.2d at 347 ("OddzOn sought copyright registration for the KOOSH ball to block importation of less expensive 'knockoffs.'").

²⁶⁵ See *supra* nn. 43-64, discussing issues of fact in the context of collateral review.

²⁶⁶ See *supra* n. 27.

²⁶⁷ *Sony Corp., Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 439 n. 19.

²⁶⁸ *Id.*

registered in the Patent Office should not result in confusing the principles involved in dissimilar proceedings with respect to wholly dissimilar rights.²⁶⁹

While trademarks and copyrights, unlike patents, do not spring from administrative action,²⁷⁰ owners of both nevertheless benefit from registration.²⁷¹ That, alone, has been seen to warrant process attention:

There is, of course, a limited statutory right to [trademark] registration, which carries certain benefits. Although . . . these are more procedural than substantive, that right cannot be denied without compliance with Fifth Amendment due process requirements.²⁷²

Because patent, trademark and copyrights statutes do not call for administrative hearings, however, APA provisions applicable to adjudications are unavailable.²⁷³ Hence, courts must provide any process found lacking.²⁷⁴

With regard to PTO merits determinations, additional process is not needed; statutes explicitly providing for trial court oversight have been interpreted to permit the introduction of new evidence and de novo review of issues thereby affected.²⁷⁵ Patent and trademark statutes do not, however, provide for review of other PTO decisions.²⁷⁶ In such circumstances APA

²⁶⁹ *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 888 (CCPA 1969). The “Patent Office” did not become the “Patent and Trademark Office” until later; Pub. L. No. 93-596 (Jan. 2, 1975) 88 Stat. 1949.

²⁷⁰ *Id.*

²⁷¹ *See e.g.* 15 U.S.C. § 1115(a) and 17 U.S.C. § 410(c) (respectively providing that trademark and copyright registrations constitute prima facie evidence of the validity of underlying rights).

²⁷² *In re McGinley*, 660 F.2d at 484. *But see In re Intl Flavors & Fragrances Inc.*, 183 F.3d 1361, 1368 (Fed. Cir. 1999) (holding, because applicants may still use their marks and retain all common law rights, “There is no constitutionally protected right to federal registration of any mark”) (*McGinley* was not cited.).

²⁷³ *See* APA now at 5 U.S.C. § 554(a) (requiring formal hearings only if subject-specific legislation so indicates).

²⁷⁴ *But see* 41 Op. Atty. Gen. 395, 399 (1959) (suggesting that intramural hearing might be required were the Office to deny registration to obscene works).

²⁷⁵ *See e.g. Winner Intl Royalty Corp. v. Wang*, 202 F.3d 1340, 1345 (Fed. Cir. 2000) (discussing review under 35 U.S.C. § 146, one of three equivalent provisions). *But see* Christopher M. Hennessey, *District Court Standards of Review in 35 U.S.C. Patentability Determinations*, 43 IDEA 677 (2003) (arguing that review should be deferential despite the opportunity to present evidence).

²⁷⁶ Thomas G. Field, Jr., *Direct Judicial Review of PTO Decisions: Jurisdictional Proposals*, 42 IDEA 537, 545-50 (2002) (discussing non-statutory review).

provisions²⁷⁷ govern, and necessary process, including *de novo* review, has been supplied by courts.²⁷⁸

So far, only Judge Kaplan has confronted the possible difference between refusals as denying the benefits of registration, on one hand, and denying the existence of rights, on the other.²⁷⁹ Indeed, in *Ward v. The National Geographic Society*, he lamented: “[O]ften it is difficult to discern whether a court is reviewing solely the propriety of registration denial or the broader issue of copyrightability.”²⁸⁰

The former furnishes the sole focus of challenges to refusals under the APA,²⁸¹ but, had any plaintiff in a § 411(a) case sought to compel registration as well as establish copyrightability of the work in question, surely that would have been mentioned. As was true of *Ward*, registration refused for lack of separate notice on a free lance magazine article long after it was published in *National Geographic*,²⁸² few suitors would derive much benefit from registration.²⁸³ Apparently because of that, Judge Kaplan said:

It is not necessary to determine what standard of review applies to the Copyright Office’s denial of registration in this case because the plaintiff has not asked this Court to compel registration and . . . the notice defect pointed out by the Copyright Office will have no bearing on the ultimate determination of copyright ownership, which requires resolution by the trier of fact.²⁸⁴

Beyond flagging a dichotomy of potential interests at stake, the opinion is unhelpful to the present inquiry. First, it evades *Norris*²⁸⁵ by referring to the way the 11th Circuit had framed the issue on appeal, not to the subsequent analysis in that opinion.²⁸⁶ Moreover, despite finding it unnecessary to address the standard of review,²⁸⁷ finding ownership to be an issue of fact²⁸⁸ and

²⁷⁷ APA now at 5 U.S.C. §§ 701-06.

²⁷⁸ See e.g., *Rydeen*, 748 F. Supp. at 903-904 (discussing alternative bases for supplying it).

²⁷⁹ *Ward v. Natl. Geographic Socy*, 208 F. Supp. 2d 429 (S.D. N.Y. 2002).

²⁸⁰ *Id.* at 447 n. 107.

²⁸¹ See *supra* Part III.C.

²⁸² Ownership of several articles was contested, but only one, published in 1974, turned on this issue. *Ward*, 208 F. Supp. 2d at 431.

²⁸³ See *supra* n. 264.

²⁸⁴ *Ward*, 208 F. Supp. 2d at 447 n. 107.

²⁸⁵ *Id.* at 447 n. 114.

²⁸⁶ See *supra* n. 227.

²⁸⁷ See *supra* n. 284 (first quoted phrase).

²⁸⁸ *Id.* (last quoted phrase).

characterizing Judge Silberman's views as dicta,²⁸⁹ Judge Kaplan agreed with Silberman's conclusion that "judicial review of questions of law, including the question of copyrightability, is entirely *de novo*" in § 411(a) cases.²⁹⁰

Concerned with ownership rather than originality, Judge Bartle's recent opinion in *Paul Morelli Designs* is only marginally more helpful²⁹¹—despite that, unlike in *Ward*,²⁹² the Office chose to join.²⁹³ While Paul Morelli's jewelry²⁹⁴ was refused registration following examination of no more than photographs:²⁹⁵

The jury not only saw and inspected [plaintiff's and defendant's] jewelry during the trial but had all of it in the jury room during deliberations. It heard extensive testimony from Paul Morelli [and experts produced by both parties] about the origin, design, elements, and manufacture of both the allegedly infringed . . . and the allegedly infringing [jewelry]. The jury also had before it evidence of other jewelry which bore on originality and creativity as well as relevant documentary exhibits.²⁹⁶

After the jury²⁹⁷ upheld the Office's refusal to register, Morelli sought a new trial based on this instruction:

While the decision of the Copyright Office is entitled to *some deference*, you are not bound by its decision and must decide for yourself the issue of copyrightability of the jewelry designs involved in this case.²⁹⁸

To justify that charge, Judge Bartle wrote:

²⁸⁹ *Ward*, 208 F. Supp. 2d at 446.

²⁹⁰ *Id.* at 447 n. 107 (citing *Atari I*, 888 F.2d at 887 (Silberman concurring)).

²⁹¹ *Paul Morelli Design, Inc. v. Tiffany and Co.*, 200 F.Supp.2d 482, 485 (E.D. Pa. 2002).

²⁹² *Ward*, 208 F.Supp.2d at 444.

²⁹³ Indeed, one of the more interesting aspects of the *Morelli* case was the (unrealized) potential for competing testimony by Marybeth Peters, the current Register, and Ralph Oman, a former Register. *Paul Morelli Design*, 200 F.Supp.2d at 486.

²⁹⁴ *Id.* at 487 n. 4 (Paul Morelli was the sole shareholder of plaintiff in *Paul Morelli Design, Inc.* and [designed the] jewelry in issue.).

²⁹⁵ *Id.* at 485.

²⁹⁶ *Id.* at 487.

²⁹⁷ A jury might not be required if only the issue of registration is involved; *see supra* at notes 280-84. It may be, however, if copyrightability is implicated. *Cf., e.g., Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 349 (1998) ("Actions seeking damages for infringement of common-law copyright, like actions seeking damages for invasions of other property rights were tried in courts of law . . ."). Assuming that a jury trial is required to determine copyright validity, it would be improper for the court to bifurcate the trial and review the registration decision itself. *Cf. Material Supply Intl, Inc. v. Sunmatch Indus Co., Ltd.*, 146 F.3d 983, 988 (D.C. Cir. 1998) (finding such an approach to violate the parties' Seventh Amendment rights in a trademark case).

²⁹⁸ *Paul Morelli Design*, 200 F.Supp.2d at 485 (emphasis added).

Although courts have articulated various standards . . . , we have taken the path followed by our colleague Sitting without a jury . . . , Judge Shapiro explained in finding for the defendant that she had given “some deference” to the . . . Office. The Court of Appeals affirmed without opinion. . . . We believe this standard strikes the proper balance between a de novo review which plaintiff seeks and the heightened abuse of discretion found in some cases. The statute, after all, gives the Register of Copyrights the right to intervene [S]ince the statute permits a party whose application was denied to sue for copyright infringement, Congress did not intend, in our view, narrowly to constrain a jury or a court from finding a rejected work to be copyrightable and infringed. . . . The charge gave the jury the appropriate latitude to differ from the Copyright Office without totally ignoring its decision²⁹⁹

De novo review was rejected because D.C. Circuit opinions supporting it³⁰⁰ “did not address the standard of review in infringement actions.”³⁰¹ The arbitrary-capricious standard was also rejected, but without analysis.³⁰²

It is easy to agree with Judge Bartle that courts or juries should not start with blank slates when considering evidence not available to the Office.³⁰³ Yet, the “some deference” standard,³⁰⁴ alone, is vague at best. Without a carefully-crafted legal standard for evaluating augmented records, juries may not appropriately credit their having much more evidence to consider. Unfortunately, *Morelli* does not repeat, much less evaluate, reasons the Office presumably gave for refusing to register the jewelry.³⁰⁵

Unfortunately, too, if the jury was given a definition of originality, it is not set out. Quoting *Feist*,³⁰⁶ Judge Bartle wrote only: “A work is original if it “was independently created by the author (as opposed to copied from other works), and . . . it possesses at least some minimal degree of creativity.”³⁰⁷ Whether a work was independently created could certainly be determined by a

²⁹⁹ *Id.* at 485-86 (citations and note omitted).

³⁰⁰ *See supra* at note 247.

³⁰¹ *Morelli*, 200 F.Supp.2d at 485 n.3.

³⁰² *Id.* at 485; only *Muller*, 802 F.2d at 990, was cited.

³⁰³ Although the presumption in 17 U.S.C. §410(c) is not facially applicable, refusals would seem to merit the same deference as certificates.

³⁰⁴ *See supra* at nn. 297-98.

³⁰⁵ 17 U.S.C. §410(b), *cf.* Judge Michel’s concurrence in *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1376 (Fed. Cir. 1998): [I]n general, the [PTO] Trademark Trial and Appeal Board’s expertise warrants great respect for its legal conclusion on likelihood of confusion However, in the rare instances such as this in which the Board fails to provide adequate explanation . . . , especially in the face of sharply conflicting findings, I question whether such respect is justified.

³⁰⁶ 499 U.S. at 345.

³⁰⁷ *Paul Morelli Design*, 200 F. Supp. 2d at 487 (ellipsis and parentheses in original).

jury, but how such a group of citizens might apply the further condition of “minimal creativity” is far from certain. For example, if the Office applied its four-selections test,³⁰⁸ and the jury was also obliged to use the same standard, overcoming a presumption³⁰⁹ that the Office correctly found Morelli’s jewelry to be unoriginal could well be impossible regardless of the quantity and quality of additional evidence he might produce.

V. SUMMARY AND CONCLUSIONS

The need to register works with the Office has long been criticized,³¹⁰ but, before rights are enforceable, all domestic copyright owners must at least attempt it.³¹¹ Moreover, foreign, as well as domestic, copyright owners obtain important advantages by doing so promptly.³¹²

If sought within five years of publication, certificates constitute *prima facie* evidence of copyright ownership and validity.³¹³ Those presumptions, however, are not strong; particularly when facts in issue could not have been or apparently were not considered by the Office, collateral challenges often succeed.³¹⁴

The Office’s capacity to refuse has perhaps generated more criticism than the need to register,³¹⁵ but the Register’s authority to refuse has been explicit since 1976.³¹⁶ At the same time claimants were given two ways to challenge the exercise of that authority³¹⁷—unfortunately with little prospect for success.³¹⁸

That may seem unfair when the odds for successful collateral challenges to registration are considered, but the disparity has several sources.³¹⁹

³⁰⁸ See *supra* nn. 254-59.

³⁰⁹ See *supra* n. 303.

³¹⁰ See *supra* nn. 28 and 29.

³¹¹ 17 U.S.C. §411(a)

³¹² See *supra* n. 264. Indeed, even refusals to register may be helpful, for example, to those who misunderstand copyright law; see *supra* nn. 109-11.

³¹³ 17 U.S.C. §410(c)

³¹⁴ See *supra* nn. 43-64.

³¹⁵ See *supra* n. 258; such criticism is long standing, see *supra* n. 106.

³¹⁶ 17 U.S.C. §410(a) (discussed *supra* nn. 122-26).

³¹⁷ *Id.* §411(a) and 701(e).

³¹⁸ See *supra* nn. 112-20. But see *supra* nn. 282-83.

³¹⁹ For example, the Office’s tendency to register when in doubt; see *supra* n. 112. But see *supra* n. 256.

Of most relevance to the present analysis is the evident basis for registration decisions: Reasons for issuing certificates are rarely available, but refusals must be explained.³²⁰ That unexplained decisions carry little weight, however, does not justify failure to credit or, as necessary, question support for the Office's position when explanations are available.³²¹

When reasons for registration were not available, observations apparently bearing on deference due to the Office's position necessarily constituted dicta. Based on one such observation,³²² the D.C. Circuit unnecessarily concluded that different standards apply depending on whether refusals are reviewed under the APA or § 411(a).³²³ Yet, the second and third sentences of § 411(a) contain no standard of review, and the *prima facie* evidence standard of § 410(c) does not apply to refusals.

Particularly when registration is not promptly pursued, failure to register could mean that a copyright claimant is merely deprived of the presumption of validity when pursuing an alleged infringer. Yet, it is difficult to imagine that foreign claimants who sue without attempting registration would face as much difficulty as domestic claimants who have been not only refused but have also been given an expert assessment of the reasons.

If so, it is insufficient to say only that the Office's assessment is entitled to "some deference." On the contrary, APA standards of review should apply regardless of whether refusals are challenged under § 701(e) or § 411(a).³²⁴

When facts are not in issue, all rejected claimants may argue that refusals rest on legislatively unsupportable or unreasonable legal bases or that the reasons for refusal cannot otherwise withstand "thorough, probing, in-depth review"³²⁵

Yet, when facts *are* legitimately contested, rejected applicants should have an opportunity to introduce evidence concerning arguments that have been presented to the Office³²⁶ and, given the inadequacy of the Office's fact finding processes, to have it considered *de novo*.

Claimants should not need to be aware of infringers to have the capacity to challenge refusals that effectively terminate rights going well

³²⁰ 17 U.S.C. §410(b).

³²¹ In *Syntek Semiconductor*, 307 F.3d at 780-81, as discussed *supra* notes 66-68, the court went so far as to seek them.

³²² *Durham*, 630 F.2d at 908 (quoted and discussed *supra* nn. 55-60).

³²³ See *supra* nn. 247-52.

³²⁴ See *Dickinson*, 527 U.S. at 165 (quoted *supra* n. 230).

³²⁵ *Overton Park*, 401 U.S. at 415 (quoted *supra* n. 183).

³²⁶ See *Oddzon*, 924 F.2d at 350 (quoted *supra* n. 151).

beyond the simple ability to sue.³²⁷ Judicial deference to the Office's findings should turn on the adequacy of administrative process, not on whether jurisdiction is based on § 701(e) or § 411(a).³²⁸

³²⁷ See 17 U.S.C. § 412 (but this assumes that attempted registration is timely under that section).

³²⁸ See *e.g. U.S. v. Rumely*, 345 U.S. 41, 45 (1953).

